Supreme Court of the United States.

OCTOBER TERM, 1903.

No. 383.

THE UNITED STATES EX RELATIONE CHARLES P. STEINMETZ, PLAINTIFF IN ERROR,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS, DEFENDANT IN ERROR.

BRIEF FOR PLAINTIFF IN ERROR.

STATEMENT OF THE CASE.

This case comes into this court on writ of error to the Court of Appeals of the District of Columbia to review the judgment of that court, affirming the judgment of the Supreme Court of the District of Columbia dismissing the petition of the relator, Charles P. Steinmetz, for a writ of mandamus against the respondent, Frederick I. Allen, Commissioner of Patents, to compel the latter to allow an appeal to the Board of Examiners-in-Chief, from a decision of the Primary Examiner refusing and rejecting, a second time, the relator's application for patent because relator would not cancel from it certain claims, as required by the Primary Examiner, under the alleged authority of certain rules of Patent Office practice and the decisions of the Commissioner of Patents thereunder.

The validity of these rules and of the Commissioner's actions thereunder is challenged by the relator, and the case is therefore one "in which is drawn in question," directly, "an authority exercised under the United States" and the "validity" of such authority. 27 Stat., 436. (U. S. *vs.* Seymour, 153 U. S., 353; U. S. *vs.* Lynch, 137 U. S., 280; U. S. *vs.* Black, 128 U. S., 40; Butterworth *vs.* Hoe, 112 U. S., 50.)

ASSIGNMENTS OF ERROR.

The following errors have been assigned:

First. The Court of Appeals of the District of Columbia erred in affirming the judgment of the Supreme Court of the District of Columbia.

Second. The court erred in affirming the judgment of the Supreme Court of the District of Columbia in dismissing the relator's petition for a mandamus.

Third. The court erred in affirming the judgment of the Supreme Court of the District of Columbia in rendering judgment in said case for the defendant.

Fourth. The court erred in not reversing the judgment of the Supreme Court of the District of Columbia and in not sustaining the relator's motion for a writ of mandamus notwithstanding the defendant's return

Fifth. The court erred in not reversing the judgment of the Supreme Court of the District of Columbia and in not directing the said Supreme Court of the District of Columbia to issue the writ of mandamus to the defendant, commanding him to direct the Primary Examiner to forward the relator's appeal to the Board of Examiners-in-Chief with a proper answer and statement as required by the rules of

practice of the United States Patent Office, to the end that the adverse decision of the Primary Examiner and the second rejection by said Primary Examiner of claims 7, 8, 9, 10, 11, 12 and 13, of the relator's application, complained of, might be revised and determined by the Board of Examiners-in-Chief, according to law.

Sixth. That the court erred in holding that the relator did not have a clear right of appeal to the Board of Examiners-in-Chief from the said decision of the Primary Examiner of the 16th day of August, 1900, complained of.

Seventh. That the court erred in holding that the said decision of the Primary Examiner, complained of, did not constitute an adverse decision upon and a second rejection of any of the claims of relator's application for patent under sections 482 and 4909 of the Revised Statutes of the United States.

Eighth. That the court erred in holding that Rule 133 of the Rules of Practice of the United States Patent Office regulating appeals is valid and not inconsistent with law.

Ninth. That the court erred in holding that the establishment of Rule 133 of the Rules of Practice of the United States Patent Office by the Commissioner of Patents is a valid exercise of an authority under the United States.

Tenth. That the court erred in holding that the defendant exercised a valid authority under the United States when he instructed and directed the Primary Examiner not to answer and forward to the Examiners-in-Chief the relator's appeal to said Examiners-in-Chief.

Eleventh. That the court erred in holding that the requirement of division of relator's application was a matter

resting entirely in the discretion of the Commissioner of Patents and not reviewable on appeal by the various statutory appellate tribunals, including the Examiners-in-Chief, the Commissioner of Patents and the Court of Appeals of the District of Columbia.

THE PETITION.

The case made by the relator's petition is substantially as follows:

On the 21st day of November, 1896, the relator filed in the Patent Office an application for patent for his invention of new and useful Improvements in Motor Meters. This application contained and still contains thirteen (13) claims, covering the different phases of the invention; claims 1 to 6, inclusive, being, in terms, directed to the novel method or process involved in the working of the invention, and claims 7 to 13, inclusive, being, in terms, directed to the novel means or apparatus by which such method is carried into practice.

On the 15th day of May, 1900, the Primary Examiner—to whom, according to law, the application was referred by the Commissioner of Patents—examined and considered the application and decided that claims 7 to 13, inclusive, to the apparatus part of the invention, must be canceled. A reconsideration of this action was requested, and was granted, and the Primary Examiner, on the 31st day of July, 1900, repeated the requirement.

Regarding this last action as an adverse decision and as a second rejection and refusal of his claims 7 to 13, inclusive, the relator appealed to the Board of Examiners-in-Chief, with a view to having the validity of the action of the Primary Examiner revised and determined by that tribunal, according to law.

The Primary Examiner, on the 9th day of August, 1900, refused to forward the appeal, with his answer thereto, on

the ground that the question involved in the appeal was not one of which the Board of Examiners-in-Chief had jurisdiction, and therefore not appealable to that tribunal. A reconsideration of this action of the Primary Examiner was requested, and granted, and the action was, on the 16th day day of August, 1900, repeated.

On the 20th day of August, 1900, the relator petitioned the then Commissioner of Patents to direct the Primary Examiner to answer and forward relator's appeal, which petition was, on the 28th day of December, 1900, denied.

On the 16th day of January, 1902, a like petition was presented to the present Commissioner of Patents, the respondent herein, and on the 7th day of February, 1902, said petition was likewise denied.

On the 28th day of February, 1902, the relator directly petitioned the Board of Examiners-in-Chief to take jurisdiction of his appeal, but this petition was, on the 6th day of March, 1902, also denied, on the ground that the Examiners-in-Chief could not, under the Rules of the Patent Office, revise and determine the validity of the Primary Examiner's action without the latter's answer to the appeal, and, further, because of the previous action of the Commissioner in the premises.

The prayer of the relator's petition is that the respondent be commanded to direct the Primary Examiner to answer and forward the relator's appeal to the Board of Examiners-in-Chief in order that the relator may have the benefit of a review of the Primary Examiner's action by the last-named tribunal and of the other appellate tribunals, if necessary.

THE RETURN.

The respondent's return admits that the relator is the true, original and first inventor of the invention for which he solicits a patent; admits that the relator's application contained and contains the claims set out in the petition,

and that the relator's claims 7 to 13, inclusive, to the apparatus part of the relator's invention, were twice required to be canceled by the Primary Examiner. It admits, further, the filing of the appeal by the relator from the decision of the Primary Examiner to the Board of Examiners-in-Chief and the taking of the various steps by the relator, as set out in the petition, in his endeavor to perfect his said appeal and to have the same determined by the Examiners-in-Chief.

It denies that any of the claims of relator's application has been twice, or at all, rejected; denies that any right of appeal to the Board of Examiners-in-Chief has accrued to relator, and attempts to justify the action of the Primary Examiner and of the respondent, on the ground that the ruling of the Primary Examiner was merely a requirement of division of relator's application under Rule 41 of Patent Office practice, which rule the Commissioner, with the approval of the Secretary of the Interior, had authority to make, and did not involve the rejection of any claim, or an action upon the merits of relator's application, such as would entitle the relator to an appeal under the statute, or under Rule 133 of Patent Office practice.

In the Commissioner's decision, made part of the return (p. 12) (Exhibit B), it is admitted that all the claims of relator's application are allowable, but it is asserted that the refusal of the Office to grant a single patent embracing all of the claims is merely "a question of procedure or of the manner of securing protection" and "not of the right of the applicant to a patent upon any of the claims presented."

The return further sets forth that the relator is estopped by his conduct to question the validity of the Primary Examiner's requirement of division; and denies, generally, the denial of any right to the relator and of the relator's right to the relief prayed.

The relator moved for judgment, notwithstanding the return.

Mr. Justice Barnard, who heard the case in the Supreme

Court of the District of Columbia, ruled that the decision of the Primary Examiner appealed from was only interlocutory in character; did not amount to a refusal or rejection of relator's application for a patent; and was not appealable under the statute or under the rules, to the Board of Examiners-in-Chief, and he denied the writ and dismissed the petition.

This judgment was affirmed by the Court of Appeals of the District of Columbia, that court holding that the requirement of division was a matter resting in the discretion of the Commissioner; that his judgment on that question was final; and that his rule made pursuant to his statutory authority to make rules, cutting off the appeal to the Board of Examiners-in-Chief from the judgment of the Primary Examiner, was valid and not inconsistent with the statute regulating appeals.

ARGUMENT.

THE UNDERLYING QUESTION.

There is one great, fundamental, underlying question presented by this case, the proper answer to which will, probably, determine the right of the relator to the relief he seeks. It is this:

> Has an applicant for a method or process patent the right to demand protection, in that patent, of all patentable invention he is *compelled* to disclose in setting forth his new method or process?

So strongly does this question appeal to our inherent sense of justice and fair play, that we are inclined, at once, to an affirmative answer to it, especially in view of the known favor with which the inventor has always been regarded by the laws and courts of our country. Nor does a more ex-

tended and thorough examination of the subject disturb this first impression.

The very nature of the contract between the inventor and the Government, as representing the public, demands that all that the inventor be required to divulge, as a condition of the grant, shall be secured to him by the instrument through which disclosure is made. An inventor is not bound to let the public into his secret, but, if he does, the plain policy of the law is to protect him to the extent of the disclosure, by the very instrument by which the disclosure, the publication, the patenting, is effected.

If a man invents a new product that can only be produced by a new process, also of his invention, he can neither patent the one, nor the other, without disclosing both, and, therefore, he should have the right to cover both in a single patent.

In like manner, if he invents a new method that is only susceptible of being practiced by the use of certain new apparatus, which new apparatus cannot in turn be effectively worked without practicing the new method, he can neither patent the one nor the other, without disclosing both, and, therefore, should be accorded the right to cover both, in one patent. The principle is the same in both cases. He has the plain right of protection, in the instrument of disclosure, of all he is compelled to divulge in communicating either part of his invention to the public.

As to the indivisibility of process and product this court has spoken with no uncertain sound. In Powder Company *vs.* Powder Works, 98 U. S., 126, Mr. Justice Bradley said (p. 137):

> "The product in Goodyear's invention was the direct result of the process. They were parts of one invention, and except in imagination, could no more be separated from each other than the two sides of a sheet of paper, or than the shadow from the body that produces it."

The case which gave rise to this expression was one involving process and product, and therefore became a precedent in the Patent Office for the permissible joinder of process and product in one patent; but, we submit, the reasoning of the learned judge applies as well to a case of process and machine, where the process requires for its practice the disclosure and use of a particular machine, and the use of the machine necessarily involves the disclosure and practice of the process. The process and machine in such cases are inseparable. Each is incapable of description without disclosing the other. They are conceived together, and the reduction to practice of one is, at the same time, the reduction to practice of the other. Why should two things so nearly identical be required to be covered by separate patents? Doesn't common sense dictate that they should be included in one patent?

THERE IS NOTHING IN THE STATUTES REQUIRING DIVISION OF PROCESS AND MACHINE.

The next inquiry is, Is there anything in the statutes compelling a division of process and machine? Our answer to this is, emphatically, No. Some, indeed, have contended for a statutory requirement of division, but the reasons advanced in support of their views will not stand the test of criticism. The requirement, if it exists anywhere, must be found in Section 4886 of the Revised Statutes, which reads as follows:

> "SECTION 4886. Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in

public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Looking back at the Constitution, from whence the power of Congress to legislate in the matter of patents is derived, we find that, with the avowed purpose of promoting the "useful arts," Congress is given power to secure to inventors for limited times, the exclusive right to their "discoveries." The use of the word "arts," in this connection, is significant, as it indicates that everything that is to be protected under the laws of Congress *shall relate to some useful art*, the term art, above all others, being the most comprehensive that could be used.

In framing section 4886, Congress, instead of using the word "art" alone, took pains, in order that there might be no misunderstanding as to what might be considered to be comprehended by that term, to superadd the words "machine, manufacture, or composition of matter."

There was no attempt made in the section quoted to define how many inventions should be embraced in a single patent, the only object being to give an enumeration of patentable things, of patentable subjects-matter.

The section is to be read in a broad and liberal spirit and with an appreciation of the idea intended to be expressed by it. Had the purpose been to announce that a single patent could embrace only an art, or a machine, or a manufacture, or a composition of matter, apt terms would have been used to give expression to that idea, so that no doubt would have been possible as to what was meant.

This section has always been construed liberally and not technically. For instance, no one has ever doubted that a joint invention of two or more persons was patentable, though the words "any person," construed strictly, would exclude a plurality of persons.

Those who contend for a statutory requirement of division between process and apparatus insist that the statute is mandatory in this respect and inhibits the granting of a single patent covering both process and apparatus. If their position be correct, the converse must also be true, that is to say, where a patent is granted for both process and apparatus, it being a grant contrary to the statute, must necessarily be invalid. But no one has been able to find a single case in which a patent claiming both process and apparatus has been declared invalid, on that account. On the contrary, the books are full of cases in which a single patent covering both these parts of an invention has been adjudicated, sustained and found to be infringed.

Merrill *vs.* Yeomans, 94 U. S., 568, decided in 1877, was such a case. This Court found that the patentee had really invented a new process, a new product and a new apparatus. He presented, however but two claims. One of these was a claim for the apparatus and the Court found it to be good, but not infringed. The other was *either* for a process or for a product, and the Court was called upon to decide which. They decided it to be a claim for a process, and to be good, but not infringed. But the Court actually recommended the patentee to apply for a reissue to cover also the *product*, which he had failed to cover. The Court evidently considered it no vice for a single patent to cover process, apparatus and product, three things named in the statute as patentable subjects-matter.

Is it to be presumed that the Court overlooked the matter of misjoinder, if any such thing existed? Why, did they not, instead of worrying over a matter of construction of one claim and suggesting another for a different, so-called, statutory subject-matter, declare the whole patent void, at once, as combining a claim for a process with a claim for an apparatus, if there was a misjoinder?

But the most notable of these cases is the greatest patent case that has ever been tried in the courts of this country—

the Telephone Case (126 U. S., 1). There never was a case in which the interests involved were as great as in this. There never was a case in which more astute counsel, learned in the law of patents, were engaged. There never was a case passed upon by judges more skilled and experienced in and familiar with the principles of patent law and with their practical application.

In this great case, not only did the principal patent cover a process and apparatus, but both of these were embodied in a single claim.

The claim read as follows:—

> "5. The method of, and apparatus for, transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth."

Of this claim the Court said:—

> "The claim is first, for the process, and second, for the apparatus. It is to be read (1) as a claim for 'the method of transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth, and (2) as for 'the apparatus for transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, * * * substantially as set forth.'"

The Court, in their opinion, said:—

> "In this art—or, what is the same thing under the patent law, this process, this way of transmitting speech—electricity, one of the forces of nature, is employed; but electricity, left to itself, will not do what is wanted. The art consists in so controlling the force as to make it accomplish the purpose. It had long been believed that if the vibrations of air caused by the voice in speaking could be reproduced at a

distance by means of electricity the speech itself would be reproduced and understood. How to do it was the question.

"Bell discovered that it could be done by gradually changing the intensity of a continuous electric current, so as to make it correspond exactly to the changes in the density of the air caused by the sound of the voice. This was his art. He then devised a way in which these changes of intensity could be made and speech actually transmitted. Thus his art was put in a condition for practical use.

"In doing this, both discovery and invention, in the popular sense of those terms, were involved: discovery in finding the art, and invention in devising the means of making it useful. For such *discoveries* and such *inventions* the law has given the discoverer and inventor the right to *a patent* —as discoverer, for the useful art, process, method of doing a thing he has found; and as inventor, for the means he has devised to make his discovery one of actual value."

The patent was upheld as a patent for both the process and the apparatus and infringement of the claim, in that double aspect, was decreed.

In view of this decree, and of the language we have quoted from the opinion, it certainly requires much temerity for any one to say that the point was not directly in judgment. That it was not argued is immaterial.

Is it to be dreamed that of all the astute lawyers for the defense in that case not one of them thought of the defense of misjoinder of inventions, if there was such a defense applicable, and is it to be presumed that the Court would have taken such pains to have dissected the invention of Bell and to have sustained claims for all its parts if the patent were invalid for misjoinder of inventions?

The Bell case was determined in 1887. In 1892 another case came before this Court involving a single patent, containing claims for a process and for an apparatus. This was the case of Hoyt *vs.* Horne, 145 U. S., 302. The court held

both claims to be good and the claim for the process to be infringed, reversing the judgment of the court below.

But cases are not wanting in which this fantastic defense of misjoinder of process and apparatus has been seriously urged, argued and directly decided.

In the Fire Extinguisher case, 21 Fed. Rep., 40, it was urged, and as distinctly and positively overruled by Judge Morris.

In his opinion Judge Morris says (page 44):—

> "The patent is further assailed by the respondents upon the ground (1) *that the patent as granted is for several separate and distinct inventions, and therefore void;* (2) that the specifications are deceptive and misleading, and therefore the patent is void; (3) that the patent covers an invention different from that set forth in the application.
>
> "As to the *first* point, the claims for which the patent was granted are four. The first and fourth are for the method of extinguishing fires by a properly directed stream of mingled carbonic acid gas and water escaping from pressure, and projected by its own expansive force; the second claim is for a portable apparatus by which the method or process could be usefully applied; and the third is for a stationary apparatus for the same purpose. If these are all proper subjects of claim, and are all inventions found in the application of Graham, then the language of the act of Congress which authorizes the Commissioner to issue a patent for whatever invention or inventions, where found in the application, is sufficient to justify his action. This was held sufficient in Evans *vs.* Eaton, 3 Wheat., 506. It was decided by the Supreme Court in Hogg *vs.* Emerson, 6 How., 483, that two or more patents may be united if they relate to a like subject, or are in their nature or operations connected together. Walk., Sec. 180. *The nature of the several claims of this patent is such that the granting of them in one patent, it seems to me, might be justified by this rule.*"

In the Patent Office, different Commissioners have ranged themselves on opposite sides of this question of the necessity of division between process and apparatus.

Division according to the so-called statutory requirement has been insisted upon by Commissioners Butterworth, Hall and Duell, and the contrary view has been vigorously maintained by Commissioners Montgomery, Mitchell and Simonds. Commissioner Butterworth gave expression to his views in Blythe's case (1885 C. D., 82); Commissioner Hall in Herr's case (1887 C. D., 105); Commissioner Montgomery in Young's case (1885 C. D., 108); Commissioner Mitchell in Lord's case (1890 C. D., 16); Commissioner Simonds in Curtis' case (1891 C. D., 206), and in Kerr's case (1892 C. D., 61); and Commissioner Duell in Boucher's case (1899 C. D., 133).

All of the Commissioners who have contended for a so-called statutory requirement of division have been compelled to admit an exception which is absolutely fatal to their main contention, *since it is not an exception to be found in the statute itself.* We refer to the joinder of process and product. There is no more justification for the exception of process and product than for process and apparatus. If a product, which is the result of the practice of an art, may be claimed in connection with the art itself, in a single patent, no good reason can be found for holding that an apparatus or machine for practicing an art may not be claimed in connection with the art itself, in a single patent.

It is said that process and product may be embraced in the same patent because, when the process produces the product and the product is produced only by the process, they are, in fact, the same invention, inseparable the one from the other. But is this not also true in many cases, of art and machine, of process and apparatus? Every improvement in a "machine" is an improvement in an art, "a useful art," or it is not patentable. Why, then, in reason, may not a single patent embrace a claim for an art and for a machine

which practices it? They are, oftentimes, inseparable, just as truly as are process and product. They "can no more be separated from each other than the two sides of a sheet of paper or the shadow from the body that produces it," to again quote Mr. Justice Bradley.

Take Bell's case, for example. He conceived of the possibility of transmitting speech, electrically, in a certain way, by a certain process. But that conception alone did not entitle him to a patent. It was only when he devised and constructed an apparatus by means of which that process could be carried into execution that, under the law, he made a patentable invention of any kind. The actual production of the whole patentable subject-matter was therefore accomplished by a single final act, the production of the competent apparatus.

Both being thus parts of the same inventive act, both being thus simultaneously born, linked together like Siamese twins, who will be bold enough to say that they were not parts of the same invention?

The Telephone case projects itself into this discussion in another way.

It will not do to say that in that case the method or process claimed was but the function of the apparatus, and that there was but one invention,—an invention of apparatus, or an invention of a process, but not of both.

It was claimed by the defendant Dolbear that the Bell patent was limited to the magneto-apparatus and magneto-method, which the defendant Dolbear did not use, but the Court said, in answer to this contention—

> "An effort was made in argument to confine the patent to the magneto-instrument and such modes of creating electrical undulations as could be produced by that form of apparatus, the position being that such an apparatus necessarily implied 'a closed circuit incapable of being opened, and a continuous current incapable of being intermittent.' But this argument ignores the fact that the claim is, first, for

the process, and, second, for the apparatus. It is to be read, 1, as a claim for 'the method of transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth;' and, 2, as for 'the apparatus for transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, * * * substantially as set forth.' The method, 'as herein described,' is to cause gradual changes in the intensity of the electric current used as the medium of transmission, which shall be exactly analogous to the changes in the density of the air, occasioned by the peculiarities in the shapes of the undulations produced in speech, in the manner 'substantially as set forth;' that is to say, 'by the vibration or motion of bodies capable of inductive action, or by the vibration of the conducting wire itself in the neighborhood of such bodies,' which is the magneto-method; or 'by alternately increasing and diminishing the resistance of the circuit, or by alternately increasing and diminishing the power of the battery, which is the variable resistance method. This is the process which has been patented, and it may be operated in either of the ways set forth. The current must be kept closed to be used successfully, but this does not necessarily imply that it must be so produced, or so operated upon, as to be incapable of being opened. If opened, it will fail to act for the time being, and the process will be interrupted; but there is nothing in the patent which requires it to be operated by instruments which are incapable of making the break.

"The apparatus, 'as herein described,' which is included in the claim, is undoubtedly one in which an electro-magnet is employed, and constructed 'substantially as set forth' in the specification. One acting on the variable resistance mode is not described, further than to say that the vibration of the conducting wire in mercury or other liquid included in the circuit occasions undulations in the current, and no other special directions are given as to the manner in which it must be constructed. The patent is both for the magneto

and variable resistance *methods*, and for the particular magneto *apparatus* which is described, or its equivalent. There is no patent for any variable resistance apparatus."

The court accordingly found, in Dolbear case, infringement of the method and not of the apparatus.

THE RELATOR'S INVENTION.

The invention of the relator is extremely complex and difficult of comprehension save by a skilled electrician. It belongs to a small but important class of cases constantly brought to the attention of the Patent Office, in which the novelty relates to the mysterious action of alternating electric currents and magnetic fluxes. The invention is founded on the conception that the 90° relation which was formerly supposed to be an essential characteristic of the alternating watt meters, is not necessary, provided three or more fluxes are used, and provided that these fluxes are properly proportioned in magnitude and phase. This conception being attained and the proper relation having been worked out, the invention, as far as the broad claims are concerned, is made. The conception involves not only the method of operation of the instrument, not only the complex interaction of the magnetic fluxes and electric currents, but also a motor meter having coils, etc., so wound, related, and proportioned as to carry out the method. It would be impossible to disclose the method to a skilled electrician without putting him in possession of information by which he could immediately and without invention work out the broad features of the apparatus. On the other hand, it would be impossible to describe the apparatus to a skilled electrician in such a way that he really understood it without putting him in possession of the method.

In order to show how intimately the method and ap-

paratus are related, we contrast below, in parallel columns, method claim 6 and apparatus claim 7:

METHOD	APPARATUS
Claim 6.	*Claim* 7.
The herein-described method of actuating an alternating-current motor meter,	In a watt meter for alternating electric currents,
which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines	
one magneto-motive force being proportional to the current	means for producing a magnetic flux proportional to the current and varying in phase therewith
and the other *two* to the electro-motive force,	means for producing a second magnetic flux proportional to the electro-motive force and lagging in phase behind the same, and means for producing an auxiliary flux along a line at an angle to said second flux and of such magnitude and phase that
the several magneto-motive forces being so proportioned and related to each other that the resultant of the last two is displaced in phase from the first by the complement of the angle of lag, and subjecting an armature to the inductive action of said field.	the resultant of the two last-mentioned fluxes will lag behind the first by the complement of the angle of lag.

It is quite clear, in view of Westinghouse *vs.* Catskill, 94 Fed., 868–871; Tesla *vs.* Scott, 97 Fed., 588, and Westinghouse *vs.* Dayton, 106 Fed., 724, that all the method claims are patentable, as they stand, and are not for the mere function of the apparatus; but relator fears that if two patents are taken out, one for the method and the other for the apparatus, it might be necessary, in accordance with the ruling in the Accumulator cases (52 Fed., 137), to elect which of these two patents he would choose to rely upon. If he elected to retain the method and abandon the apparatus, he would be obliged to proceed against all manufacturers under the doctrine of contributory infringement, and would also be obliged to abandon any detail apparatus claims which he might make in the case. If, on the other hand, he elected to abandon the method claims and relied entirely upon the apparatus claims, he would lose some of the most important claims in the case and very likely might be unable to successfully proceed against some infringer utilizing the real gist of his invention.

No case could be presented illustrating better the hardship of requiring division.

Aside from the Commissioner's arbitrary rule on the subject, no reason has been advanced, or can be advanced, why there should be division. The method and apparatus claims do not fall within different classes of invention according to official classification; they go to the same class. They are not required to be examined by different examiners; they go to the same examiner. They require no further examination, at all; they have been examined on their merits and the examiner and the Commissioner have both declared all of them allowable (p. 12).

THE PATENT OFFICE RULE AS TO JOINDER WHEN RELATOR'S APPLICATION WAS FILED.

In 1896, when the relator's application was filed, the rules promulgated by Commissioner Simonds, April 1, 1892, were in force. The rule as to joinder of inventions read as follows (p. 12):

> "41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application."

Inasmuch as claims for a process or method and claims for a machine for carrying out that method "are often dependent upon each other and mutually contribute to produce a single result," such claims were, in proper cases, permitted, under this rule, to be placed in a single application, as decided by Commissioner Simonds in Curtis' case (1891 C. D,. 206) and in Kerr's case (1892 C. D., 61).

When Commissioner Duell, the respondent's immediate predecessor, began to tinker with the rule, he made an addition to it, which he caused to be italicised, so that the rule, as a whole, read as follows (Rules, July 18, 1899):

> "41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.
>
> "*A machine, a process and a product are separate and independent inventions, and claims for each must be presented in a separate application.*"

The promulgation of this italicised addition raised a storm of protest from members of the patent bar and others throughout the country, and resolutions condemnatory of the amendment were passed by the Patent Law Bar Asso-

ciation of Chicago, and by the Patent Bar Association of Washington, and the subject was investigated and reported upon by a Committee of the Patent, Copyright and Trade-Mark Section of the American Bar Association (Reports Am. Bar Ass'n, 1900, p. 553), and Commissioner Duell was memorialized by all these bodies to strike out his amendment. The most that he would do, however, was to modify his amendment so as to permit the claiming of process and product in the same application. As thus modified, the rule took its present form, viz:

> "41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application.
>
> "*Claims for a machine and its product must be presented in separate applications.*
>
> "*Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications.*
>
> "*Claims for a process and its product may be presented in the same application.*"

The effect of Mr. Duell's amendments, upon relator's case, was to render illegal (from the standpoint of the Office) an application that was perfectly legal and proper when it was filed, nearly three years before!

It was a breach of faith to demand of relator a division of his application, at so late a day, and it is to repeat it now.

The old rule, so far as it was not inconsistent with law, had the binding effect of the statute itself and was and is as operative upon the Office as it was and is upon applicants.

Whatever else may be said of a Commissioner's power to make rules, he certainly cannot make such as are retrospective in their operation. He cannot, by rule, take away the vested rights of applicants. He cannot, by rule, increase the cost of applicant's protection 100 per cent., or at all, after application filed.

This line of argument of course tends most strongly to show why the relator's application should be relieved of the oppression of the *new* rule, but it also illustrates the general abuse of the rule-making power of the Commissioner which we criticise elsewhere in this brief.

THE RELATIVE WEIGHT TO BE GIVEN THE DECISIONS OF VARIOUS COMMISSIONERS.

Now, what relative weight is to be given the decisions of the various Commissioners on this subject of joinder? Commissioners Butterworth and Hall went to their posts without previous preparation in patent law or practice and their decisions on this subject of joinder were therefore those of inexperienced patent lawyers and, moreover, were made in 1885 and 1887, respectively, before the Telephone case was decided, and, apparently, without any consideration of the Fire Extinguisher case. Commissioners Mitchell and Simonds succeeded Mr. Hall, in the order named. Both were patent lawyers of ripe experience and both held that joinder of process and machine was admissible. Mr. Mitchell was especially competent to deal with the subject. He came to the Office with a national reputation for ability of the first class. He was one of the leaders of the patent bar. He came not to learn patent law, nor to make it; but to expound and administer it; which he did, most ably. No one will dissent from this.

At an early day, the question we have now under discussion was presented to him and, in the well-considered case of *Ex parte* Lord (C. D. 1890, p. 16) he examined the whole subject, including the Butterworth and Hall decisions, the Telephone case, Merrill *vs.* Yeomans, and the Fire Extinguisher case, and came to the deliberate conclusion that his predecessors, Commissioners Butterworth and Hall, were wrong and out of harmony with the decisions of this Court; that there was no so-called statutory requirement sepa-

rating process from product, or process from apparatus, and that where these several and distinct parts of an invention are dependent upon each other and mutually contribute to produce a single result, they may be embraced in a single patent. How any one, after reading Mr. Mitchell's masterly exposition of this subject, can have any doubt of the correctness of his views we are at a loss to understand. His decision would make a good brief for this case, and we commend it to the careful consideration of the Court.

The argument of Mr. Commissioner Duell in favor of statutory classification is contained in his decision in *Ex parte* Boucher, C. D. 1899, p. 133; but, subsequently to that decision, he was obliged to admit the unsoundness of it by conceding an exception which the statute did not make, *i. e.*, the joinder of process and product, and by amending his rule so as to permit joinder of those subjects-matter. In the Boucher case he admits that no decision can be found invalidating a patent because embracing claims for process and apparatus. He intimates that no decision has ever been made squarely upon the point, but says—

> "If a case is ever presented for consideration which compels the decision of the question I fail to see how the patent can either lawfully or logically be upheld."

But in saying this he overlooks the Fire Extinguisher case, in which the precise point was directly decided, and he overlooks the controlling authority of the Telephone case, which decides, point blank, that a single patent for process and apparatus is valid and that it is proper to embrace both these subjects in a single patent.

His ground for presuming that if a case did arise involving the point the patent would be held to be invalid is based upon an entire misconception of the rulings of the Supreme Court in reissue cases.

He says:

> "I am of the opinion that if an ordinary case comes before the court for consideration where it becomes necessary to decide the question in view of the decisions of the courts in reference to reissue patents with claims for the process which originally contained claims only for the apparatus, the chances very much favor a decision holding the patent under consideration to be invalid."

If he had investigated, closely, he would have found that in those reissue cases the reissues were declared invalid, not because it was improper to join claims for a process and for a product, or for a process and an apparatus, in the same patent, but because the reissue of a process patent into a product patent, or of a product patent into a process patent, or of a process patent into an apparatus patent, or of an apparatus patent into a process patent, or of an apparatus patent, with a limited claim, into an apparatus patent with a broad claim was not permissible, since, *in each of the cases mentioned*, the reissued patent would not be for the *same invention* as the original patent, that is, would not claim the same invention as that *claimed* in the original patent.

In James *vs.* Campbell, 104 U. S., 356, an apparatus patent was reissued into a process patent and the latter was declared invalid; in Powder Co. *vs.* Powder Works, 98 U. S., 136, a process patent was reissued into a product patent and the latter was declared invalid; in Miller *vs.* Brass Co., 104 U. S., 350; Parker & Whipple Co. *vs.* Yale Clock Co., 123 U. S., 87, Hoskins *vs.* Fisher, 125 U. S., 217, Yale Lock Co. *vs.* James, 125 U. S., 447, and in many subsequent cases, machine or apparatus patents, with narrow claims, were reissued into machine or apparatus patents, with broad claims, and the latter were declared invalid.

In all these cases, covering almost every phase of the subject, the reissues were deemed bad because not for the same inventions patented, *i. e., claimed*, in the originals. There

was no ruling, in any of them, to the effect that no single patent could contain claims for process and apparatus, any more than there was a ruling that a single patent could not contain process and product claims, or broad and narrow claims for apparatus. All that was decided, in any of the cases, is consistent with the soundness of our contention that claims for process and apparatus, process and product, and broad and narrow claims for apparatus, may be lawfully joined in a single patent.

The only prohibition this Court has ever put upon the right to include several distinct and separate parts of an invention in a single patent, is found in the case of Hogg *vs.* Emerson, 6 How., 483, where the Court said :

> " But it is a well established exception that patents (inventions) may be united, if two or more included in one set of letters relate to a a like subject, or are in their nature or operation connected together."

In that case the patentee's, Emerson's, claims covered :

> (1.) A cam cylinder and pin on a piston rod, as a substitute for a crank, in a steam-engine.
> (2.) A spiral propelling wheel for a boat.
> (3.) A revolving vertical shaft to turn a boat's capstan.

All these instrumentalities were shown as mounted and used upon a boat. The patent successfully withstood a second assault, at a second hearing, on a larger record.

Hogg *vs.* Emerson, 11 How., 587.

The whole tendency of the courts has of late years been towards the condemnation of undue subdivision of invention and of undue multiplication of patents.

In Electric Accumulator Company *vs.* Brush Electric Company, 52 Fed. Rep., 137, the Circuit Court of Appeals for the Second Circuit said :

> "The result of this subdivision of the main invention, the alteration of specifications, and the grant of divisional patents at different dates, was to make an entangled mass of patents, which are to some extent intertwined with each other,—a confusion which has caused perplexity to experts, counsel, and judges and which has endangered the strength and the validity of the patents themselves."

And the tendency on the part of the Patent Office to require too much subdivision of invention is strongly condemned by Judge Lacombe in Johns Mfg. Co. *vs.* Robertson *et al.*, 89 Fed. Rep., 506, as follows:

> "For some unexplained reason (probably because of some arbitrary rule of the Patent Office), instead of allowing a reissue, with appropriate claims, the Office on the same day allowed two separate reissues—the one above quoted, and another, numbered 10,375, which purports to cover practically the same invention, only not restricted as to the composition of the non-conducting sheets. This practice of so-called 'divisional issue' has been most unfortunate for patentees. Witness the result in Underwood *vs.* Gerber, 149 U. S., 224; 13 Sup. Ct., 854. And, as was to be expected, the defendants contend that No. 10,376 is anticipated by No. 10,375. Fortunately, in the case at bar it will not be necessary to deprive the inventor wholly of his patent because the Patent Office saw fit to split it into two."

We have here given more attention to the arguments for and against a statutory requirement of division of process and machine than the subject, perhaps, deserves, in view of the fact that the respondent, the present Commissioner, apparently has no confidence in it, since he defends solely on the ground that the matter of division rests entirely in the *discretion* of the Commissioner and that the Commissioner's opinion on the matter, in any given case, is final.

THE ALLEGED DISCRETION OF THE COMMISSIONER IN REQUIRING DIVISION OF PROCESS AND MACHINE.

That the Commissioner of Patents has an unreviewable discretion in the determination of the important question as to whether claims for a process and for the apparatus for carrying the process into effect shall be embraced in one or more patents, we emphatically deny.

Such discretionary power is claimed to be derived from his power to make regulations for the conduct of proceedings in his office, conferred by Sec. 483, Revised Statutes which reads as follows:

> "§ 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office."

Now, some of the evils that grow out of requiring an inventor to take two distinct patents, one for his process and the other for his machine for carrying that process into effect, are these:

(*a.*) The inventor cannot patent the process without disclosing the machine, nor the machine, without disclosing the process, and the issue of a patent for either, alone, puts the public in possession of the other before it is protected by patent, with all the attendant embarrassing consequences.

(*b.*) The inventor is required to pay double fees; meaning by this, not only double fees to the Government for the examination and for the preparation of the patent, but double fees to the solicitor for the preparation and prosecution of the two cases.

(*c.*) The two patents may become the property of different owners.

(*d.*) Infringers may be subject to two independent suits, either by the same or by different plaintiffs.

(*e.*) The two patents, if granted, one for the process and the other for the machine, may, if issued at different times, become public property at different dates, to the embarrassment of the public.

(*f.*) The owner of the process patent is liable to suit at the hands of the owner of the machine patent to prevent him from using the machine as the best and only means of practicing the process.

(*g.*) The owner of the machine patent can sell machines without, perhaps, conferring upon the purchaser the right to practice the process intended to be practiced by it, and the owner of the process patent can grant a right to use the process without, perhaps, conferring the right to use the only machine that can practice it.

(*h.*) The machine patent may be sold to a purchaser who has no knowledge of the pedency of an application for an after-issued process patent, and *vice versa.*

(*i.*) It gives no opportunity to the inventor to claim, in a single patent, an invention, in both aspects, where doubt exists, whether the real invention is a process or a machine.

Take the Bell Telephone Patent, for instance. Who would, in advance of the adjudication, have risked deciding that the invention was either in the process or in the apparatus, and what wisdom was shown in making and securing, in the same patent, claims covering both?

Not only has the solicitor to contend with his own doubt, but he has to take into consideration the possible frame of mind of the judge who may be called upon to adjudicate the patent.

How will the judge view the matter? May he not say, if the claim is, in form, for a process, that the invention is really for an apparatus, and that an apparatus is not claimed; or, on the contrary, if the claim is, in form, for an apparatus, may he not decide the invention to be an apparatus, which the defendant does not use, and not for a process, which the defendant does use?

In Boyden *vs.* Westinghouse, 170 U. S., 537, this Court, of its own motion, ordered a rehearing and reargument on the question, whether one of the claims in issue was a claim for a machine or a claim for a process.

But if the solicitor is permitted to put both claims in the same patent, as he should be, then the real invention is covered, whether viewed as a process or as an apparatus, and the infringer is held.

There should be the same latitude accorded inventors in the statement of their invention as both process and apparatus that is accorded inventors of generic inventions relating to process and product, or wholly to process, or wholly to apparatus.

Can it be said, then, that the authority of the Commissioner to make rules governing mere procedure can extend to the power to make rules affecting so profoundly as this the fundamental rights of inventors? Is it a mere regulation of proceedings to require an inventor to split up a really indivisible invention into parts, with the possibility of losing protection for one of the most valuable parts by so doing? Is it a mere regulation of proceedings to require an inventor to pay two sets of fees instead of one,—to increase the cost of his protection 100 per cent.?

We contend that to require the applicant to divide his case and file a second application is to impose a condition upon his right to a patent not found in the Statutes, and, perhaps, impossible of performance. The applicant may not have the funds for another application; he may be at the end of his resources. If so, compliance with the Com-

missioner's request means the absolute loss of a very valuable part of his invention, or of the whole of it if he decide to patent it, as a process, when he should have patented it as as apparatus, or *vice versa*.

The protection of the inventor has always been a matter of special solicitude on the part of Congress, and Congress never intended that the cost of a patent to him should depend upon the whims of Commissioners of Patents.

When Congress fixes the cost of a patent the Commissioner has, plainly, no authority to add a dollar thereto. No usage in regard to making an excess charge can legalize it, and the excess can be recovered back by suit (Ogden *et al. vs.* Maxwell, 3 Blatch., 319; S. C., Federal case No. 10458). In the case last mentioned, which was a suit brought against the collector of the port of New York for the recovery of fees illegally exacted, Judge Betts said:

> "The transactions at a collector's office, which are made subject to charges or fees, are enumerated in the statute and the compensation to be collected for each act done by him is specially stated. In the levy of these emoluments he is governed by the limitations no less than by the express directions of the statute. No equity or usage in respect to these rates of compensation can be appealed to, as a sanction for a departure from the terms of the act. * * * The statute gives no reward except for doing the individual act named, and no consideration of convenience to either or both of the parties or saving of expense by substituting another practice in place of that directed by law will authorize a collector *colore officii*, to charge and receive compensation for a service differing from that appointed by positive law.
>
> "Numerous adjudications of the courts of the United States in this District have declared that when a rate of fees to an officer of court is established by statute for a particular service it is illegal in the officer to charge or accept a greater fee for that service.
>
> "The rule is equally stringent in the State courts,

> An action of assumpsit will lie by the party making payment against the officer to recover back the overcharge. (M'Intyre *vs.* Trumbull, 7 Johns., 35.) And, if the act be done corruptly, it is extortion and subjects the officer to indictment. (People *vs.* Whaley, 6 Cow., 661.)
>
> "The custom or usage alleged to prevail at this port to make constructive charges for granting permits, whatever may be its notoriety or continuance, is void, both because it contravenes the spirit of the statute and also because there is no warrant of law, except under the statute, for imposing any charge or fee for that official act. The defendant would, without the aid of the statute, be guilty of extortion in levying fees of any kind for his official services."

This Court, in Swift & Courtney & Beecher Co. *vs.* United States, 111 U. S., 22, quoted with approval Judge Betts' ruling, saying:

> "And in Ogden *vs.* Maxwell, 3 Blatch., 319, it was held that illegal fees exacted by a collector, though sanctioned by a long-continued usage and practice in the office under a mistaken construction of the statute, even when paid without protest, might be recovered back on the ground that the payment was compulsory and not voluntary."

Clearly, then, the Commissioner's power to make mere regulations cannot be used as a cloak for requiring the division and separate patenting of the parts of a really unitary and indivisible invention, nor for exacting a double set of fees from an applicant.

If any such power was intended to be given, Congress would have, in terms, conferred it. It cannot be inferred from a mere permission to make rules regulating procedure.

COMMISSIONER IS NOT SUSTAINED BY DECISIONS OF THIS COURT.

There is no adjudicated case to which our attention has been called in which the so-called discretionary power of the Commissioner, as to requiring division of applications for original patents, was directly in judgment.

The respondent referred to two cases in his brief in the court below, namely, Bennett *vs.* Fowler, 8 Wall., 445, and McKay *vs.* Dibert, 19 O. G., 1351; C. D. 1881, 238, but neither of them reaches to the point.

In Bennett *vs.* Fowler two *reissued patents*, carved out of a single original patent, were in suit, and the defendant contended that the Commissioner had exceeded his authority in permitting the reissue in two divisions, and the point was overruled. What was said by the Court, in a general way, about there being some discretion in the Commissioner in the matter of division, must be held to apply reissued patents only, for such patents only were involved in that case, and, furthermore, must be taken in connection with the then existing statute, Sec. 5, of the Act of 1837 (5 Stat., 191) [amendatory of the Sec. 13 of the Act of 1836 (5 Stat., 117)], which provided for an option on the part of an applicant for reissue as to whether he should take one or several reissued patents, as follows:

> "SEC. 5. That, whenever a patent shall be returned for correction and reissue under the thirteenth section of the act to which this is additional, *and the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented*, he shall first pay, in manner and in addition to the sum provided by that act, the sum of thirty dollars for each additional patent so issued," etc., etc.

The fact that "distinct and separate parts of the thing patented," in the original patent, could be covered by separate

reissues, at the option of the applicant for reissue, indicates clearly that it was no vice to cover in a single original patent the said "distinct and separate parts" of the invention.

In McKay *vs.* Dibert, an original patent for a machine was issued to the inventor, Blake. After it was issued the same inventor applied for a second patent, claiming, first, a process, and, secondly, a product—an article of manufacture. The Commissioner advised him that he could not claim both process and product in the same patent (it is different now, for Rule 41 allows the claim of process and product in the same application); whereupon he struck out the claim for the product and filed a new application therefor. Two patents, one for the process and the other for the product, were subsequently granted him, on the same day.

The first patent, that for the machine, having expired while the later patents for process and product still remained in force, an infringer used the machine of the expired patent, and, in such use, practiced the process of the unexpired process patent and made the product of the unexpired product patent, claiming the right to do this by virtue of the expiration of the machine patent.

On these facts, the Court, Judge Nixon, observed (C. D. 1881, p. 240):

> "We have thus presented for consideration an interesting and novel question. All embarrassment would have been avoided if the officers of the Patent Office had required the inventor, when he applied for the process and product patent, to surrender his original patent for the mechanism, and had then made three several reissues for the machine, the process and the product, all bearing the same date and expiring at the same time. Such course was pursued in the case of The Rubber Company *vs.* Goodyear, 9 Wall., 788), where the inventor first patented the process and afterward surrendered the letters patent and took his reissue in two several patents, one for the product and the other for the process of the product; but such a step was not required in the present case,

> and it is a fair inference, from what was decided in Bennett *vs.* Fowler, 8 Wall., 445, that the courts have no absolute control over the head of the Patent Office in the exercise of his discretion whether a given invention or improvement shall be embraced in one, two or more letters patent."

Certainly, neither of these cases can be said to be of controlling authority on the question presented by this record.

It is not contended that, in all cases, process and apparatus claims are proper to be joined in a single patent, and the ancient part of Rule 41 provides for this.

Cases will be presented where process claims, so-called, are in reality but claims for the functions of an apparatus. Such claims, on examination, will be rejected for that reason. But the applicant is entitled to present his claims for both process and apparatus in a single application, as covering parts of his fundamental invention, and to have the judgment of all the statutory tribunals on the question of his right to make such claims.

The present rule is arbitrary, by requiring division without any determination whatever of the question of right to the claims.

In the present case no discretion has been exercised in dealing with this particular application and determining whether it is of such a character that its process and apparatus are or are not dependent, or so disunited as to require division. The Examiner has declined to look into the application. He held himself bound by a hard and fast rule.

The Examiners, the Examiners-in-Chief, and the Commissioner, acting as an appellate tribunal, are all judicial officers, as this court has twice decided (Butterworth *vs.* Hoe, 112 U. S., 50; U. S. *vs.* Duell, 172 U. S., 576), and the duty of determining whether an application contains claims for inventions which "are dependent upon each other and mutually contribute to produce a single result," or even of deciding whether the claims, in a given case, are all for a

process or all for a machine, or are some for a process and some for a machine (a question that bothered this court in Boyden *vs.* Westinghouse, 170 U. S., 537), is clearly a judicial duty, involving, oftentimes, the nicest application of the rules for the interpretation of patents.

The Commissioner's theory of the operation of present rule 41 is manifestly incorrect. His contention is that the action of the Examiner, under the rule, relates to mere matter of form and procedure and does not affect at all the merits of the application.

Of course the Examiner's action affects the merits; in the nature of things it must do so. That claims are alike or different in their nature is a judicial question and its resolution is a judicial determination, and, as such, is appealable.

If as the Commissioner contends the present rule requires division without examination,—without any determination whatever of the right to the claims, the division required by it might just as well be done by the application clerk as by the Examiner, for the latter's action under it is purely perfunctory. He might upon opening the application see that the first claim is for a process and the next is for an apparatus, and, without any inquiry whatever as to patentability, call upon applicant to divide, pursuant to Rule 41. This is what he has done, in effect.

And then a most extraordinary thing occurs. When applicant looks to the next rule (Rule 42) to see what he must do to meet the Examiner's requirements, he finds this confronting him, as the first paragraph of that rule—

> "42. If several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them, the inventor will be required to *limit the description, drawings and claim* of the pending application to whichever invention he may elect."

Now, it will be remembered he has claimed, originally, process and apparatus, and, of course, has described and shown in his application a competent and, perchance, the only known apparatus for executing the process, in strict obedience to the requirements of Secs. 4888 and 4889 of the Statutes.

This other rule (42) now requires that, if he will hold on to his claim for process, he must strike from his specification and drawings the only thing that can support his process claim—*i. e., the description and illustration of a way in which the process may be worked.*

Nothing could better illustrate the unsoundness of Mr. Duell's amendments. They render the other rules and the statute itself ridiculous.

This is a great question. Mr. Duell's amendments have not settled it. His prophecy that it might be regulated by his rule has not been realized. The trial that he says in the last paragraph of his decision in the Boucher case should be made has been made, and the great unrest exhibited by the bar at large shows that the trial has been a failure. Resistance to the Rule will not down. The matter has been discussed at large by the bar. As hereinbefore stated, it has been made the subject of careful and painstaking examination by the Patent Section of the American Bar Association, by the Patent Bar Association of Chicago, and by the Patent Bar Association of Washington, and all of these bodies have passed resolutions condemning the Rule. Nothing could be more disinterested than the position of the bar upon this subject. Division makes business and doubles fees for both solicitors and lawyers, and yet hardly a respectable member of the bar can be found who does not regard the Rule, in its present form, as arbitrary, unjust, oppressive and a reproach to the administration of the patent system.

THE RIGHT OF APPEAL.

So far, we have attempted to show the inherent right of an inventor to a single patent covering all he is compelled to disclose as the condition of the grant to him of any protection, and to show the absence of any statutory authority to require him to divide up his invention and take multiple patents for its parts. We will now endeavor to show that whenever an application for patent is a second time refused by the Primary Examiner because, as in the case at bar, it contains claims to a process that can only be practiced by the use of a certain machine and also claims to the machine for practicing such process, the applicant is entitled to an appeal from the Examiner's ruling, to all the statutory appellate tribunals, in turn, and upon a favorable decision of any of such tribunals, is entitled to have a patent issued to him.

HISTORY OF THE EXAMINATION SYSTEM.

As this branch of the discussion involves a somewhat exact knowledge of the present jurisdiction and powers of the various officers and tribunals in and out of the Patent Office charged with the duty of determining the rights of applicants for patents, we will first draw the attention of the Court to the origin and development of the scheme of examination so characteristic of the American patent system.

Under the original Patent Act of 1790 (1 Stat., 109) the Secretary of State, the Secretary of War and the Attorney General, or any two of these officials, were given power to grant patents for inventions which they "deemed sufficiently useful and important."

No examination as to novelty or originality was required to be made.

By the Act of 1793 (1 Stat., 318) the Secretary of State was substituted for the tribunal of three created by the prior act;

but still no examination for novelty or originality was required.

By the Act of 1836 (5 Stat., 117) a separate Bureau of the Department of State was established, to be known as the Patent Office, and the office of Commissioner of Patents was created.

Section 7 of the Act required the Commissioner "to make, or cause to be made, an examination of the alleged new invention or discovery" for novelty, utility, originality, etc.

The Commissioner was, by Section 2, given authority to appoint an Examining Clerk to assist him in his duties, but the responsibility of the examination and of action thereupon was laid upon the Commissioner himself.

Where an applicant, after a second rejection by the Commissioner, refused to modify his specification and claim, he might, under Section 7, appeal to a Board of Examiners, consisting of three disinterested persons appointed by the Secretary of State, "one of whom, at least," was selected, "if practical and convenient, for his knowledge and skill in the particular art, manufacture or branch of science to which the alleged invention appertains." On such an appeal the Commissioner was required to certify to the Board of Examiners his opinion and decision, "stating the particular grounds of his objection and the part or parts of the invention which he considers as not entitled to be patented," and the Board had power "to reverse the decision of the Commissioner either in whole or in part, and their opinion being certified to the Commissioner" the latter was "governed thereby in the further proceedings to be had on such application."

The applicant was required to pay into the Treasury twenty-five dollars on the taking of his appeal, and each member of the Board was entitled to receive a sum not exceeding ten dollars for his services in determining the appeal.

The Act of 1837 (5 Stat., 191), section 11, authorized the appointment of an additional Examining Clerk to assist the Commissioner in the discharge of his duties.

Under the Act of 1839 (5 Stat., 353) the examining force was increased by the appointment of the two (2) Assistant Examiners.

The act also gave an appeal from the Commissioner to the Chief Justice of the District Court of the United States for the District of Columbia in substitution for the appeal to the Board of Examiners theretofore allowed.

The appeal fee remained at $25 (section 1) and the Chief Justice received annually an additional $100, in consideration of the special duties thus imposed upon him.

By section 10 of the act the applicant was given the right to file a bill in equity where his patent was refused "for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia upon appeal from the decision of said Commissioner."

By the Act of 1848 (9 Stat., 231) the examining corps was authorized to be further increased by the appointment of two (2) additional Principal Examiners and two (2) additional Assistant Examiners.

By the Act of 1849 (9 Stat., 395) the Patent Office was transferred to the Department of the Interior.

By the Act of 1852 (10 Stat., 75) the right of appeal from the Commissioner was extended to include an appeal to the Assistant Judges of the Circuit Court of the District of Columbia, and the appeal fee of $25 was required to be paid over by the Commissioner to the Chief Judge or Assistant Judge called upon to determine any particular case.

By the Act of 1855 (10 Stat., 670) four (4) more Principal Examiners and four (4) more Assistant Examiners were added to the force.

By the Act of 1856 (11 Stat., 91) two (2) more Principal Examiners and two (2) more Assistant Examiners were added.

The Act of 1861 (12 Stat., 246), recognizing apparently the need of an independent appellate tribunal in the Patent Office between the Principal Examiners and the Commissioners, created the present tribunal known as the Board of Examiners-in-Chief.

Section 2 of the Act reads as follows:

> "SECTION 2. *And be it further enacted*, That for the purposes of securing greater uniformity of action in the grant and *refusal* of letters patent, there shall be appointed by the President, by and with the advice and consent of the Senate, three Examiners-in-Chief, at an annual salary of three thousand dollars each, to be composed of persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the applicant for that purpose being filed, to revise and determine upon the validity of decisions made by examiners *when adverse to the grant* of letters patent; and also to revise and determine in like manner upon the validity of the decisions of examiners in interference cases, and when required by the Commissioner in applications for the extension of patents, and to perform such other duties as may be assigned to them by the Commissioner; that from their decisions appeals may be taken to the Commissioner of Patents in person, upon payment of the fee hereinafter prescribed; that the said Examiners-in-Chief shall be governed in their action by the rules to be prescribed by the Commissioner of Patents."

The passage of this Act of 1861 was productive of profound consequences in the administration of our patent system. The Principal or Primary Examiners (as they are indifferently called) instead of remaining mere clerks to the Commissioner became independent tribunals of first instance. From their favorable decisions no appeal lay. From their adverse decisions appeal was given, at first without fee, to the Board of Examiners-in-Chief; from adverse decisions of the latter tribunal appeals lay to the Commissioner in person,

and from decisions of the Commissioner appeals lay to the Judges of the Circuit Court of the District of Columbia.

The fate of an applicant no longer depended alone upon the judgment of the Commissioner of Patents himself—who was not a permanent officer and often a mere politician, unversed in patent law or any other kind of law—but, in the first instance, upon the judgment of the Primary Examiner and then upon the new special tribunal—the Board of Examiners-in-Chief—composed of officers required to be "persons of competent legal knowledge and scientific ability."

It is true that the Board might be reviewed by the Commissioner on appeal, but the decision of the latter was not final, and was, in turn, reviewable by the judges.

The Act was construed to deprive the Commissioner of the power to pass upon the merits of applications, except upon regular appeal from the Board of Examiners-in-Chief, notwithstanding the continued existence of that provision of the Act of 1836, which directed the Commissioner to "make or cause to be made" an examination, etc. (Snowden *vs.* Pierce—Case No. 13,151, Federal Cases).

By the act of March 3, 1863, establishing the Supreme Court of the District of Columbia, the Justices of said Court were clothed with the same power theretofore exercised by the Judges of the Circuit Court.

By the act of 1867 (15 Stat., 10) a fee of $10 was required to be paid upon appeal from the Primary Examiner to the Board of Examiners-in-Chief.

By the Act of 1868 (15 Stat., 168) the Examiner-in-Chief oldest in length of commission supplied the vacancy caused by the death, resignation, absence or sickness of the Commissioner.

Under the Act of 1869 (15 Stat., 293) the examining corps was expanded to include twenty (20) Principal Examiners, twenty (20) First Assistant Examiners and twenty (20) Second Assistant Examiners.

A later Act of 1869 (19 Stat., 11) added two more Principal Examiners.

The act of 1870 (16 Stat., 198) increased the examining force to one Examiner in Charge of Interferences, twenty-two (22) Principal Examiners, twenty-two (22) First Assistant Examiners and twenty-two (22) Second Assistant Examiners.

This Act continued the Board of Examiners-in-Chief, and, beyond question, took away every vestige of the Commissioner's power to personally make an original examination of an application, if any remained, after Judge Dunlop's decision in Snowden *vs.* Pierce, by substituting, in Section 31, the words "shall cause an examination to be made" for the words "make or cause to be made" of the Act of 1836.

The review of the Statutes, thus far made, shows how the Commissioner of Patents, from a judicial or quasi-judicial officer, having exclusive jurisdiction to determine the merits of applications for patents, *in the first instance*, with a gradually increasing force of examining clerks to assist him, has been transformed into an officer having *appellate jurisdiction only* and whose judgments are subject to review by the Court on direct appeal; also how the Examiners, from mere clerks to the Commissioner, have become transformed into judicial or quasi-judicial officers having *original* jurisdiction of applications and subject to review, not by the Commissioner directly, but first by an independent, intermediate, permanent tribunal of specialists, *i. e.*, the Board of Examiners-in-Chief on appeal, and then on appeal from the latter to Commissioner in person.

These conditions continue substantially, at the present day, under existing law, as will be seen upon examining the Revised Statutes and the Acts of Congress passed subsequent thereto.

Section 476 of the Revised Statutes provides for the appointment by the President of the Commissioner, one Assist-

ant Commissioner and three Examiners-in-Chief by and with the advice and consent of the Senate.

The Commissioner receives a salary of $5,000 a year and the Assistant Commissioner and the Examiners-in-Chief $3,000 a year each.

There are now on the rolls of the office 39 Principal or Primary Examiners, 41 First Assistant Examiners, 50 Second Assistant Examiners, 61 Third Assistant Examiners and 70 Fourth Assistant Examiners, besides five additional clerks assigned to the duty of making examinations.

The general powers and duties of Commissioner are defined by Section 481, as follows:

> "SEC. 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law, and he shall have charge of all books, records, papers, models, machines and other things belonging to the Patent Office."

His power to make regulations is defined in Section 483, as follows:

> "SEC. 483. The Commissioner of Patents, subject to the approval of the Secretary of the Interior, may from time to time establish regulations, *not inconsistent with law*, for the conduct of proceedings in the Patent Office."

The powers and duties of the Examiners-in-Chief are found in Section 482, as follows:

> "SEC. 482. The Examiners-in-Chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be on the written petition of the appellant to revise and determine upon the validity of the *adverse decisions of examiners upon applications for patents*, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions and perform such other like duties as he may assign them."

Section 4886 defines what may be patented and section 4888 states what the application for patent must contain.

Section 4893 requires the Commissioner to *cause* an examination to be made upon the filing of an application, as follows:

> "SEC. 4893. On the filing of any such application and the payment of the fees required by law the Commissioner of Patents *shall cause an examination to be made* of the alleged new invention or discovery, and if on such examination it shall appear that the claimant is justly entitled to a patent under the law and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

In case of the rejection of any claim for a patent the duty of the Commissioner is made plain by section 4903, which reads as follows:

> "SEC. 4903. Whenever on examination *any claim for a patent is rejected* the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case."

The Act of 1870 (16 Stat., 198, Sec. 41) was like Section 4903 save that it contained after the word "rejected" the words "for any reason whatever." The omission of these words in the revision indicates that Congress intended that the Commissioner should notify the applicant when any of his claims for a patent was rejected *whether for or without reason.*

The Patent Office regulation made pursuant to Section 4903 is modeled rather on the lines of the old Statute than on the new one. It reads as follows:

> "Rule 65. Whenever on examination any claim of an application is rejected *for any reason whatever* the applicant will be notified thereof. The reasons for such rejection will be fully and precisely stated, and such information and references will be given as may be useful in aiding the applicant to judge of the propriety of prosecuting his application or of altering his specification; and if, after receiving such notice, he shall persist in his claim, with or without altering his specification, the application will be re-examined. If upon re-examination the claim shall be again rejected the reasons therefor will be fully and precisely stated."

Section 4909 makes it clear that the person whom the Commissioner shall cause to make the examination is the Primary Examiner, for it provides:

> "SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may *appeal from the decision of the Primary Examiner*, or of the Examiner in Charge of Interferences in such case to the Board of Examiners-in-Chief, having once paid the fee for such appeal."

The Patent Office regulations on the subject show that this is the construction placed on the section by the Patent Office

> "133. Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed or because the amendment involves a departure from the invention originally presented, and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent is not inoperative

or invalid, or if so inoperative or invalid that the errors which rendered it so did not arise from inadvertence, accident or mistake, may, upon payment of a fee of $10, appeal from the decision of the *Primary Examiner* to the Examiners-in-Chief. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

"134. There must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and all the claims must have been passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled before the case can be appealed to the Examiners-in-Chief.

"135. Upon the filing of the appeal the same shall be submitted to the *Primary Examiner*, who, if he finds it to be regular in form, shall, within *five* days from the filing thereof, furnish the Examiners-in-Chief with a written statement of the grounds of his decision on all the points involved in the appeal, with copies of the rejected claims and with the references applicable thereto. The Examiner shall at the time of making such statement furnish a copy of the same to the appellant. If the Primary Examiner shall decide that the appeal is not regular in form a petition from such decision may be taken directly to the Commissioner, as provided in Rule 145."

The appeals from the Examiners-in-Chief to the Commissioner in person and from the Commissioner to the Court of Appeals of the District of Columbia are regulated by the following provisions of the Revised Statutes of the United States:

"SEC. 4910. If such party is dissatisfied with the decision of the Examiners-in-Chief he may, on payment of the fee prescribed, appeal to the Commissioner in person.

"SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

"SEC. 4912. When an appeal is taken to the Supreme Court of the District of Columbia the appellant shall give notice thereof to the Commissioner and file in the Patent Office within such time as the Commissioner shall appoint his reasons of appeal, specifically set forth in writing.

"SEC. 4913. The Court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the Court may prescribe to all parties who appear to be interested therein. The party appealing shall lay before the Court certified copies of all the original papers and evidence in the case and the Commissioner shall furnish the Court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the Court, the Commissioner and the examiners may be examined under oath in explanation of the principles of the thing for which a patent is demanded.

"SEC. 4914. The Court, on petition, shall hear and determine such appeal and revise the decision appealed from in a summary way on the evidence produced before the Commissioner at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the Court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and shall govern the further proceedings in the case. But no opinion or decision of the Court in any such case shall preclude any person interested from the right to contest the validity of such patent in any Court wherein the same may be called in question.

"SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity, and the Court having cognizance thereof, on notice to adverse parties and

other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, *as specified in his claim or for any part thereof* as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the Commissioner, and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not."

the following section of the Revised Statutes relating to the District of Columbia:

"SEC. 780. The Supreme Court, sitting in banc, shall have jurisdiction of and shall hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of section forty-nine hundred and eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, Title LX, of the Revised Statutes of the United States, Patents, Trade-Marks and Copyrights."

(See R. S. U. S., p. 958. See R. S. U. S., Sec. 699);

and also by Section 9 of the Act of February 9, 1893, establishing the Court of Appeals of the District of Columbia, as follows:

"SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act;

"And, in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

Having by this review of the Statutes shown the gradual development of the examination system into the present proportions, the vast increase in the number of officials now engaged in carrying it on and the clear-cut division of the examining and reviewing tribunals into Examiners, Examiners-in-Chief, Commissioner and Court of Appeals of the District of Columbia, each having exclusive jurisdiction in its particular sphere *and none having any original jurisdiction save the Examiners*, we think we have put before the Court enough to enable it to decide the following vital question which this record presents, namely:

> Was the action of the Primary Examiner of the 31st day of July, 1900, requiring and demanding a second time the cancellation of claims 7 to 13, inclusive, of relator's application, as a condition of the grant of a patent to him on said application, an *adverse decision* upon or *second rejection of his said application*, or of *said claims*, such as entitles him to an appeal to the Board of Examiners-in-Chief?

THE RELATOR'S RIGHT OF APPEAL HAS ACCRUED UNDER THE STATUTE.

The statutory jurisdiction of the Board of Examiners-in-Chief would certainly seem broad enough to give that tribunal power to review the action of the Primary Examiner complained of. Section 482, R. S., says:

> "SEC. 482. The Examiners-in-Chief shall be persons of competent legal knowledge * * * whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the *adverse decisions of examiners* upon applications for patents" * * *

Surely the decision of the Primary Examiner complained of was *adverse* enough. It certainly was not favorable. It barred, and still bars, the progress of the application. It

prevented, and still prevents, the issue of relator's patent. Could anything be more adverse?

The respondent's return admits (p. 8) that *all* the claims of the relator's application are allowable and that the only question left is the question of division (p. 12), and the application is refused because of this adverse decision respecting it.

As the Statute imposes upon the Examiners-in-Chief the *duty* of revising and determining the validity of the adverse decisions of the Examiners, it by the clearest implication gives an applicant the right of appeal to them from such adverse decisions. So, without reference to any other section of the Statute, the relator's right of appeal from the Examiner's action complained of in this case seems clear under Section 482.

But if relator's right of appeal depends upon the provisions of Section 4909, alone, such right is equally perfect thereunder. The section says:

> "SEC. 4909. Every applicant for a patent or for the reissue of a patent, *any of the claims of which have been twice rejected* * * * may appeal from the decision of Primary Examiner * * * to the Board of Examiners-in-Chief."

If any of relator's claims for a patent have been rejected at all they have been twice rejected. This the return admits. The question is, Has any claim been rejected at all?

What does "rejected" mean as used in the section?

In the interpretation of Statutes it is a general rule that common words are to be given their plain, ordinary, popular meaning. Tested by this rule we find the word "reject" (*rejectus*, to throw back) to be universally used as the equivalent of "refuse," especially when used to indicate a denial of a petition or request.

We quote below from some of the Standard Authorities:

Webster's International Dictionary

Reject—To refuse to grant, as to reject a prayer or request.

Refuse—To decline to accept; to reject; to deny the request or petition.

Century Dictionary

Reject—To refuse to receive.

Refuse—To decline to accept; reject; as to refuse an office, to refuse an offer.

Standard Dictionary

Reject—To refuse to grant, as to reject an application or petition.

Refuse—To withhold acceptance of; reject, as to refuse an offer.

Soule's Synonyms

Reject—Decline, refuse, repudiate, repel, rebuff.

Refuse—Reject, repudiate, exclude, repel, rebuff, decline.

International Dictionary and Cyclopedia

Reject—To refuse to grant, as to reject a petition or request.

Refuse—To decline to accept; to reject.

Richardson's English Dictionary

Refuse—To deny; to reject; to give a negative to any request or petition.

American Encyclopedic Dictionary

Reject—To refuse to grant, as to reject a petition or request.

Refuse—To deny that which is solicited, demanded or sought; to decline to do or grant; not to comply with; to decline to accept; to reject.

That the word "rejected" was used by Congress in Sections 4903 and 4909 in the sense of "refused" is perfectly apparent from the fact that in Section 4915, found in the same Act, which gives to an applicant the right to *further*

prosecute his claim for a patent by a bill-in-equity proceeding, after final adverse action by the Commissioner, or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the word "refused" is used instead of "rejected" to indicate the action of the Commissioner or of the Court sought to be reviewed, the language being:

> "4915. Whenever a patent on application is *refused* either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity;" * * *

Note, here, that it is the refusal of *a patent*, of the whole application, and not of claims, merely, that gives the right to file a bill in equity. Unquestionably, the proceeding is but another step in the prosecution of applicant's right to a patent. Gandy *vs.* Marble, 122 U. S., 432; Butterworth *vs.* Hoe, 112 U. S., 50.

Assuming, then, that the word "rejected" in Section 4909 means "refused" was any of relator's claims refused by the Primary Examiner when he a second time required and demanded that claims 7 to 13, inclusive, be canceled?

Clearly the claims referred to were not granted, and just as clearly they were refused. To not grant them was to refuse them, and to require and demand that they be canceled, expugned, thrown out, was a complete refusal, rejection and suppression of them, so far as the Primary Examiner, by any action on his part, could accomplish that result.

Of course, to insist upon unreasonable conditions, or upon conditions which jeopardized any inherent or statutory right of the applicant, is equivalent to a refusal.

In the present case, the Examiner "refused" or "rejected" the claims because, without determining whether or not the process and apparatus were or were not mutually dependent upon each other, and merely because of the arbitrary and, as we have shown, illegal requirement of Rule 41,

declined to take any action to give the applicant the benefit of the appeal to the Examiners-in-Chief to which he was entitled by law.

The whole application was refused and rejected in the sense that the application, as a whole, came to a standstill and could not and cannot proceed at all unless and until compliance with the Examiner's requirement, or the reversal of his ruling, on appeal. Could there be a refusal more emphatic? How absurd to hold that if one claim is rejected an appeal will lie, but that if the whole application is rejected no appeal will lie!

The refusal and rejection is none the less complete because the Examiner intimates that the refused and rejected claims may be allowed *in another application*. The relator has not applied for two patents, but for one patent—for one patent covering all the parts of what he believes and claims to be his invention. The Examiner had no right to act to compel him to file two applications. A single patent, covering his whole invention, the relator claims the right to have, under the Statute, upon the payment of a single set of fees. The very section we have just quoted (Sec. 4915) says, "whenever *a patent* on application is *refused*," indicating that it is the refusal of *a patent* for any cause, whether because the application contains no novelty, or too many claims, or too many inventions, or because it is rejected upon an illegal rule of practice, or what not, that may be reviewed.

IF RULE 133, REGULATING APPEALS, ADDS ANY CONDITIONS OF APPEAL NOT FOUND IN THE STATUTE IT IS NULL AND VOID.

Section 482, R. S. U. S. guarantees, as we have seen, a right of appeal to the Board of Examiners-in-Chief from the "adverse decisions of Examiners upon applications for patents," and Section 4909, R. S. U. S., gives, in terms, a right

of appeal to any applicant "any of the claims of which have been twice rejected."

The Commissioner's Rule 133 provides:

> "133. Every applicant for a patent, any of the claims of whose application have been *twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented;* and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent is not inoperative or invalid, or if so inoperative or invalid that the errors which rendered it so did not arise from inadvertence, accident or mistake, may, upon payment of a fee of $10, appeal from the decision of the Primary Examiner to the Examiners-in-Chief. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent."

Now if, as respondent contends, the Examiner's requirement was not a "second rejection *upon grounds involving the merits of the invention*," and, consequently, was not an action which gave a right of appeal under Rule 133, then Rule 133 is invalid, void and of no effect, because inconsistent with law in that it curtails and cuts down the statutory right of appeal from "adverse decisions" *of any kind* (Sec. 482) and "second rejections" *of any kind* (4909) to a right of appeal from *second rejections for the same reasons upon grounds involving the merits of the invention.* The Statute says nothing about a rejection *for reasons*, nor about rejections upon *grounds involving the merits of the invention* (Com'r of Patents *vs.* Whitely, 4 Wall., 552). Rejection for or without

reason, and rejections upon the merits of the invention or otherwise, are equally within its purview, and the Commissioner, by rule, can add nothing to nor subtract anything from the statutory requirements, to the prejudice of an applicant.

Morrill *vs.* Jones, 106 U. S., 466.
Tracy *vs.* Swartwout, 10 Peters, 80.
Kurtz *vs.* Moffit, 115 U. S., 487.
Teal *vs.* Fulton, 12 How., 285.
Anchor *vs.* How, 50 Fed., 367.

Under the Act of 1839 appeals were allowed from the Commissioner to the Chief Judge of the Circuit Court of the District of Columbia, and the Act of 1852, without taking away that power, extended the right of appeal so as to lie to either of the Assistant Judges. The Chief Judge having become very infirm the Commissioner undertook, by rule or order, to restrict appeals to the Assistant Judges only, and the legality of his action having been drawn in question the opinion of the Attorney General of the United States, Mr. Cushing, was asked and obtained thereupon. Mr. Cushing, in giving his opinion, said:

> "The Commissioner undertook to require and order that in all cases of interfering patents that the appellant, who shall have, theretofore, taken an appeal to the Chief Justice shall, within fifteen days after notice of the order, amend his appeal by taking it to one of the Assistant Judges, and on his neglect so to amend that a patent shall issue to the appellee, and that thereafter all appeals shall be taken to one of the Assistant Judges, or else shall issue to the adverse party. I conceive these orders to be a plain violation of law. The Commissioner has assumed to make a statute repealing an Act of Congress."
>
> 6 Opin. Att'ys Gen'l, 38 (June 2, 1853).

In the case of Morrill *vs.* Jones, 106 U. S., 466, above cited, under a statute providing that "animals, alive, specially im-

ported for breeding purposes from beyond the seas, shall be admitted free (of duty) upon proof thereof satisfactory to the Secretary of the Treasury, and under such regulations as he may prescribe" the Secretary of the Treasury prescribed a regulation providing that before a collector should admit such animals free he must, among other things, be satisfied that "the animals are of superior stock, adapted to improving the breed in the United States." The collector, though the importation was for breeding purposes, demanded the duties because he was not satisfied that the animals were of *superior stock*.

But this Court, speaking through Mr. Chief Justice Waite, said:

> "The Secretary of the Treasury cannot, by his regulations, alter or amend a revenue law. All he can do is to regulate the mode of proceeding to carry into effect what Congress has enacted. In the present case we are entirely satisfied the regulation acted upon by the collector was in excess of the power of the Secretary. The Statute clearly includes animals of all classes. The regulation seeks to confine its operation to animals of 'superior stock.' This is manifestly an attempt to put into the body of the Statute a limitation which Congress did not think it necessary to prescribe. Congress was willing to admit duty free all animals specially imported for breeding purposes; the Secretary thought this privilege should be confined to such animals as were adapted to the improvement of breeds already in the United States. In our opinion the object of the Secretary could only be accomplished by an amendment of the law. That is not the office of a treasury regulation."

The analogy between that revenue case and the case at bar is striking. The Commissioner of Patents, not satisfied with the Statute and not recognizing a right of appeal from every adverse decision or second rejection by an Examiner, required that the adverse decision should be of "superior

stock," *i. e.*, "a second rejection, for the same reasons, upon grounds involving the merits of the invention," thereby exceeding his authority, by unduly limiting the right of appeal, as much as the Secretary of the Treasury did by his regulation.

In this conflict between the Statute and the regulation the latter necessarily goes to the wall and cannot be invoked by the respondent for his protection in this proceeding.

It may be remarked, in passing, that it is not true, as intimated by counsel for respondent in the court below, that the Office rule regulating appeals has been the same for the past thirty years.

The rules promulgated in 1870 by Commissioner Samuel S. Fisher, who, perhaps, had as much to do with the formulation of the Patent Act of 1870 as any one person, contained the following provision respecting appeals:

> "42. Every applicant for a patent or the reissue of a patent any of the claims of which have been twice rejected and every party to an interference, may appeal from the decision of the Primary Examiner or of the Examiner in charge of interferences, in such case, to the Board of Examiners-in-Chief, having once paid a fee of $10. For this purpose a petition in writing must be filed, signed by the party or his authorized agent or attorney, praying an appeal and setting forth briefly and distinctly the reasons upon which the appeal is taken."

This rule, it will be observed, follows closely the Statute. It was continued by Mr. Fisher's successors down to November, 1876, when Commissioner R. H. Duell amended it so as to read:

> "42. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected *upon the merits of the invention*, may appeal from the decision of the Primary Examiner to the Board of Examiners-in-Chief," etc.

In this amended form the rule continued till 1879, when Commissioner Paine changed it so as to contain an attempt at a specification of things regarded as affecting the merits, viz.:

> "128. Every applicant for a patent or the reissue of a patent, any of the claims of whose application have been twice rejected upon grounds involving the merits of the invention, *such as lack of novelty or utility, abandonment, public use, or want of identity of invention, either in amended or in reissue applications,* may appeal from the decision of the Primary Examiner to the Board of Examiners-in-Chief," etc.

This form prevailed, in substance, until the time of Commissioner Seymour, who, by his code of rules, promulgated February 9, 1897, struck out the rule entirely, appreciating, doubtless, that the various amendments and additions of his predecessors had taken it farther and farther from the Statute.

In the preface to his rules Commissioner Seymour made the following statement:

> "The rules of procedure have been revised on the following lines:
>
> "First. To remove from the rules those sections of the Revised Statutes which have, from time to time, been incorporated in them, and in place of incorporating certain sections in the rules, it has been decided to publish the Statutes, revised to the present time, in full, in the same pamphlet with the rules."

His new appeal rule was very simple:

> "71. In *ex parte cases* upon the filing of an appeal or petition the Primary Examiner shall, ten days before the date of hearing, furnish the appellate tribunal and the appellant or petitioner with a statement of the grounds of his decision."

The wisdom of thus relying upon the Statute itself for a statement of grounds of appeal is apparent from our discussion of the present rule.

Mr. Seymour's work was, in turn, uprooted by his immediate successor, Mr. Butterworth, and the old rule, in substantially its present form, was readopted.

That Mr. Seymour believed that a requirement of division might amount to a rejection of merits and give a right of appeal to the Board of Examiners-in-Chief is apparent from the decision of his assistant in *ex parte* Bellingrodt (54 MSS. Dec., 474), printed as an Appendix to this brief which was foreshadowed in his own decision in *ex parte* Thomson, C. D. 1894, p. 8; 66 O. G., 653, wherein he said (p. 10):

> "Since division between process and product may produce confusion in the arts and conflicting interests, as intimated by the Court in McKay *vs.* Dibert (C. D. 1881, 238; 19 O .G., 1351, 5 Fed. Rep., 587) and since no patent has been declared void by reason of the joinder of such claims, while many have been held to be valid, and since manifest advantages would follow from one uniform rule as to division, and, more important than all else, since division or joinder *approaches if it does not present* a question of right in the applicant to choose between two courses, both of which are open to him, it is broadly announced that division in such cases should not be required."

RELATOR'S RIGHT OF APPEAL HAS ACCRUED UNDER RULE 133, IF RULES 41 AND 133 ARE PROPERLY CONSTRUED.

The action of the Primary Examiner which gave rise to the lodgment of the appeal in this case to the Board of Examiners-in-Chief was made pursuant to Patent Office Rule 41.

Rightly or wrongly the Examiner rejected claims 7 to 13, inclusive, of relator's application because of this rule. He said, in effect, your application contains claims to an appa-

ratus and claims to a process, and the process claims must go.

Did this objection, right or wrong, go to the merits of the invention? If it did, there was a clear right of appeal, not only under the Statute, but under Rule 133.

If the relator had made thirteen apparatus claims and seven of them had been rejected as not involving invention, he would have had, admittedly, a clear right of appeal. If, too, the Examiner had rejected the aforesaid seven apparatus claims on the ground that they were not warranted by the original disclosure in the application, or because they covered mere aggregations and not legitimate combinations, there would also have been, unquestionably, a right of appeal. All of these objections would, admittedly, have gone to the merits of the invention, *for Rule* 133 *says so.*

How about the requirement compelling the relator to throw away seven of his valuable apparatus claims on the ground that they couldn't be entertained there? Are they not parts of his invention? Does not their cancelation affect the merits as much as, and more than, a question as to whether a claim is in the form of an aggregation or of a legitimate combination?

The fact that a process and an apparatus for carrying it into effect are distinct inventions or distinct parts of an invention does not militate against their joinder in the same application under the rule. Every application that contains two or more process claims or two or more apparatus claims embodies claims for two or more distinct inventions. Each claim in an application or in any patent is supposed to be patentably distinguished from every other claim and to cover a distinct invention. Multiple claims are granted on no other theory.

The first paragraph of Rule 41 provides that "where several distinct inventions are dependent upon each other and mutually contribute to produce a single result *they may be claimed* in the same application."

Mr. Commissioner Mitchell, than whom no better patent lawyer ever graced the Patent Office, in his admirable decision, in the case of *ex parte* Lord (50 O. G., 987; G. D., 1890, p. 16), held that process and apparatus might be, and often were, dependent upon each other and mutually contributed to produce a single result, and that, therefore, they might be claimed in the same application. When Mr. Mitchell rendered this decision he was construing Rule 41, as it then stood—that is, without that *addition* made by his successor, Mr. Commissioner Duell, which now reads:

> "Claims for a machine and the process in the performance of which the machine is used must be presented in separate applications."

But what Mr. Mitchell said is as true today as it was when he said it, and Mr. Duell's addition to the rule must still be read to mean that process and apparatus must be presented in separate applications *unless they are "dependent upon each other and mutually contribute to produce a single result,"* in which case they may be claimed in a single application.

The Examiner in relator's case must be held to have practically decided that the process and apparatus claimed by relator were not dependent upon each other and did not mutually contribute to produce a single result, *and his decision on that question of fact goes to the merits of the case and is clearly appealable.*

THE REFUSAL OR REJECTION OF AN APPLICATION, OR OF ANY OF THE CLAIMS THEREOF, UNDER A RULE OF PRACTICE, IS NOT DIFFERENT, IN KIND, FROM A REFUSAL OR A REJECTION UNDER THE STATUTE ITSELF, AND IS APPEALABLE.

The respondent and the Court below seem to think that the refusal by the Primary Examiner of a patent to the relator on the ground that the latter's application is obnoxious to the provisions of Rule 41 is different, in kind, from a re-

fusal or rejection of the application on the ground that it is obnoxious to some provision of the Statute; that the one involves a question of office practice or procedure, merely, and the other a question of the merits. No such distinction, we submit, can be made.

The rules of the Office made pursuant to statutory authority, *and not inconsistent with law*, have all the force and authority of the Statute itself, and are, so long as they remain unrepealed, as binding upon the Office as they are upon applicants.

U. S. *vs.* Eliason, 16 Pet., 291.
Gratiof *vs.* U. S., 4 How., 80.
In re Hirsch, 74 Fed., 931.
Wilkins *vs.* U. S. (C. C. A.), 96 Fed., 837.
James *vs.* Germania Iron Co., 107 Fed., 597–609.
D. C. *vs.* Roth, 18 App. D. C., 547.
Rio Grande Irrigation Co. *vs.* Gildersleeve, 174 U. S., 603.

When, therefore, claims 7 to 13, inclusive, of relator's application were refused, *in that application*, because of alleged repugnancy to the provisions of Rule 41, such refusal or rejection was the same, in kind, as a refusal or rejection of them on the ground that they were obnoxious to the statute (sec. 4886), requiring that they embody patentable subject-matter, and such refusal became, in effect, a statutory refusal or rejection of them, went directly to the merits of the application, was final, and all the statutory appellate tribunals may be invoked to review the soundness of the Primary Examiner's action in making such refusal or rejection. Mark, in this connection, the aptness of language in the statutory provision respecting appeals:

> "SEC. 4909. Every applicant for a patent or for the reissue of a patent, *any of the claims of which have been twice rejected*, etc., may appeal from the decision of the Primary Examiner, etc., to the Board of Examiners-in-Chief."

It may possibly transpire that the Primary Examiner has, in the case at bar, acted wisely and well, and all the appellate tribunals whose jurisdiction is invoked may affirm his decision, but that is not the question. It is not a question as to *how* the appellate tribunals are going to decide, but as to *whether they have an opportunity to decide at all.*

It seems to us that there can be but one answer to relator's contention. If the Primary Examiner has refused to allow applicant's claims 7 to 13, inclusive, in the pending application, and has demanded their cancellation from that application, because of supposed repugnancy to Rule 41—which has the force and effect of the Statute, if valid—he has refused and rejected such claims under that rule, and all of the statutory appellate tribunals have the right, at least, to say whether or not the rule has been properly applied, just as they would have the right to say whether a rejection grounded on the alleged lack of one of the direct statutory prerequisites, such as novelty of subject-matter, was properly made or not.

THE HEARING OF THE COMMISSIONER ON INTERLOCUTORY PETITION IS NO SUBSTITUTE FOR THE STATUTORY APPEAL.

The respondent contends that the Examiner's requirement of division is a matter of form, not appealable to the Board of Examiners-in-Chief, but reviewable by the Commissioner, upon interlocutory petition, without fee, and further, that the Commissioner's decision upon such questions is final and unreviewable.

To this we reply:

1. No such mode of reviewing an adverse decision of a Primary Examiner is recognized by the Statute.

2. If the Commissioner has indulged an applicant by giving him the benefit of his opinion on such question, on mere petition, without fee, in advance of acquiring jurisdic-

tion on regular statutory appeal, and it has been customary for the Primary Examiner to act in accordance with such opinion, applicants have perhaps been justified in invoking the Commissioner's aid in that way, but their right to a regular statutory appeal to the Examiners-in-Chief, to the Commissioner and to the Court of Appeals, on such a question, has not thereby been waived or prejudiced.

3. It is a question whether the Commissioner, by entertaining and deciding such interlocutory petitions, as a matter of grace, without fee, has not deprived the Government of the revenue which would have accrued from the fees on regular appeal to him through the Examiners-in-Chief, amounting to $30, in each case, and laid himself open to most unfavorable criticism by such action.

4. It is absurd to contend that the decision of the Commissioner is final upon such a grave question as the right of an applicant to have the whole of an invention he is compelled by law to disclose covered by a single patent, the very instrument of disclosure. Was it not for the purpose of reviewing the action of the Commissioner on just such important points, affecting, profoundly, the rights of an inventor, that the Court of Appeals of the District of Columbia was set above the Patent Office?

We contend, most strenuously, that the Commissioner cannot by offering his advice on interlocutory petition, on such a matter, either short-circuit the jurisdiction of the Board of Examiners-in-Chief, or deprive the Court of Appeals of its right of reviewing him.

5. The Commissioner's power to make a final, unreviewable decision upon so important and vital a matter is neither derived from his power to make regulations nor from his general supervising powers conferred by Sec. 481.

While it is true that the latter section imposes upon him

the duty to "superintend or perform all duties respecting the granting and issuing of patents directed by law," it does not give him the power of original examination of applications where that duty is lodged elsewhere, *i. e.* in the Primary Examiner; it does not give him the power to review, in the first instance, the judgments of the Primary Examiners on questions of patentability, or any other questions affecting the rights of an applicant to a patent, when that duty is lodged elsewhere *i. e.*, in the Examiners-in-Chief; any more than it gives him the right to refuse a patent after the Court of Appeals have adjudged, on appeal from him, an applicant entitled to one.

Some of the limitations on his powers and duties are expressed in Section 4893, viz:

> "§ 4893. On the filing of any such application and the payment of the fees required by law, the Commissioner of Patents *shall cause* an examination to be made of the alleged new invention or discovery; and if *on such examination* it shall appear that the claimant is *justly entitled to a patent under the law*, and the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

Under this section he is to "cause an examination to be made" not to make it himself, and "if on such examination it shall appear" (to the Examiner, not to the Commissioner) "that the claimant is justly entitled to a patent under the law" he "shall" *i. e.*, *must* issue a patent. His only power to reject or refuse a patent arises when a case comes before him on regular, statutory appeal.

6. If the Commissioner's decision was *final* on the question of division, in this case, then it was final as to everything else for, as the return shows (p. 12) *that was the only question left open*, the novelty and patentability of *all* the claims, and every other question, having been disposed of.

THE DEFENSE OF ELECTION AND ESTOPPEL.

The respondent in his return sets up the demand of the relator for an interference with a patent upon a method claim, after being advised by the Examiner that such a demand would be deemed and taken to be, by the Office, an election to stand on method claims alone, and as an abandonment of his right to persist in his apparatus claims on the termination of the interference, and as an estoppel upon his right to further prosecute his apparatus claims in the present application.

The point is absolutely without merit, and constitutes no defense to relator's petition.

In the first place, the requirement of the Examiner was unlawful and was of no effect against the relator's right to prosecute his application in respect of all its claims. The relator consented to nothing, acquiesced in nothing. He demanded an interference, as he had a right to do, and the Commissioner being satisfied that an interference existed, declared it, as required by law. It is not true, as contended by respondent, that the interference could not and would not have been declared if the alleged election had not been made by the relator. Dungan, with whom an interference was demanded, was a patentee, and the practice as recognized in the recent case of *Ex parte* Spoon, 97 O. G., 1375, decided November 2, 1901, during the respondent's administration, permitted and required an interference, notwithstanding questions not directly involving the right of the applicant to make the claim in interference were still unsettled in the applicant's application. The threat of the Examiner, the relator considered to be idle and frivolous, and attached no more importance to it than he would have to a demand for $100, as a condition of declaring the interference. He is now no more estopped and concluded from insisting upon his right to further prosecute his application, as to all its

claims, than he would be estopped to resist a demand for $100 at the hands of the Examiner in the case supposed.

But if the relator were bound as by an election, or estopped by his conduct, the action of the Primary Examiner of the 31st day of July, 1900, complained of, was a *second rejection* of relator's claims 7 to 13, inclusive, *on that ground*, and is clearly appealable to the Board of Examiners-in-Chief. An estoppel, of course, goes to the merits.

The respondent may call the Examiner's action a requirement of division, a demand for cancellation of claims, a judgment as upon an election, or as upon an estoppel, or as upon a matter *res adjudicata*, or as upon anything else; whatever it may be termed, it was an "adverse decision" a second time made, and a "second rejection" of relator's claims 7 to 13, inclusive, and, consequently, is the proper subject of review, on appeal, by the Board of Examiners-in-Chief.

RESPONDENT HAS MAGNIFIED THE CONSEQUENCES OF ALLOWING APPEALS IN CASES LIKE RELATOR'S.

The respondent argues that the relator's right of appeal contended for in this case, if admitted, would operate most disastrously, by permitting appeals to all the statutory appellate tribunals on all questions of mere procedure and Office practice arising under the rules.

That we may not misstate respondent's position, we quote the following from the brief filed in his behalf in the court below:

> "If an applicant is entitled to appeal to the Court of Appeals from the Commissioner's ruling upon this question of procedure, he is entitled to such appeal from any requirement which the Commissioner may make during the prosecution of the application which the applicant does not wish to comply with, although that requirement has nothing to do with the merits of the applicant's claim or his right to a patent. For

> instance, the Commissioner may require that papers filed in the case be written upon one side of the paper only, or be written in permanent ink, and if the applicant does not wish to comply with the requirement, he may regard the action as a rejection of all claims made by him in the case and appeal to the several tribunals of the Patent Office and to the court."

This line of argument is specious and unsound, and demonstrably so.

The relator contends for the right of appeal from such actions of the Primary Examiner as are made under *rules that are inconsistent with the plain provisions of the Statute.* He claims no right of appeal from actions under rules that are not open to this criticism and, of course, there are many such—

To illustrate: Section 4888 R. S. U. S. requires that—

> "SEC. 4888. Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, *in writing* to the Commissioner of Patents, and shall file in the Patent Office a *written description* of the same," etc., etc.

Now, if the Commissioner, pursuant to his statutory authority to make rules, should promulgate a rule requiring that the application should, to quote the respondent's illustration, "be written upon one side of the paper only or be written in permanent ink," the rule would be a perfectly proper one, and no statutory appeal would lie from the action of a Primary Examiner enforcing it. But suppose the Commissioner should make a rule requiring that all applications for patent should be presented *in print,* and refusing consideration of any application that was written with a pen, would such a rule be considered a legal exercise of his power to make rules not inconsistent with law? Would such a rule be upheld by this Court? Manifestly not. In case of the

presentation of a *written* application and of the refusal of the Primary Examiner to receive it and to examine it, under such a rule and of the refusal of the Commissioner to direct the Examiner to receive it and examine it, mandamus would clearly lie to the Commissioner to compel him to direct the Examiner to do his duty under the law, notwithstanding the rule, and the Court would not hesitate to declare the rule "inconsistent with law," and therefore null and void. (Morrill *vs.* Jones, 106 U. S., 466.)

To make our point clearer, let us put another case.

Section 4909 R. S. U. S. provides that—

> "SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been *twice rejected*, etc., etc., may appeal from the decision of the Primary Examiner, etc., to the Board of Examiners-in-Chief," etc.

Now, suppose the Commissioner should make a rule requiring that there should be *three* rejections of a claim by the Primary Examiner before an applicant should have the right of appeal, and, after two rejections, an applicant should lodge his appeal to the Board of Examiners-in-Chief, and the Primary Examiner should refuse to answer it and forward it with his answer to the Board of Examiners-in-Chief, on the ground that the case was not in appealable condition, under the Commissioner's rule; and that the Commissioner should, on application, refuse to direct the Examiner to answer and forward the appeal, does any one doubt that mandamus would lie to the Commissioner in such a case to compel him to direct the Examiner to treat the appeal as a perfected appeal? In the case at bar the situation is not essentially different from that of the case last put.

MANDAMUS IS RELATOR'S PROPER REMEDY.

The Primary Examiner charged with the duty of passing upon an application in the first instance may reject or refuse

any claim made in it, but his decision upon such a question is not final. Elaborate judicial machinery has been devised, as we have seen, to review the Examiner's actions. The first revision is by the Board of Examiners-in-Chief, the second by the Commissioner of Patents in person and the third by the Court of Appeals of the District of Columbia, all on regular, statutory appeals. None of these tribunals has jurisdiction to pass upon the question in advance of its coming to it by regular appeal. None of them has any original jurisdiction, but each has ample power as an appellate tribunal, and the right of an applicant to invoke that power cannot be throttled and taken away by any possible action of a Primary Examiner, of a Commissioner of Patents, or by anybody else so long as the courts of the country are open to him.

The courts should not, we contend, except upon statutory appeal, determine the validity of any ground of rejection urged by a Primary Examiner (Frasch's Case, D. C. App., 100 O. G., 1977), but they can and will clear away any and every obstruction to an applicant's right to a revision of an Examiner's action by the duly constituted statutory, appellate tribunals provided for the purpose.

Any interference with a right of appeal is never tolerated and mandamus is the proper remedy to remove any obstruction to the exercise of the right.

U. S. *vs.* Gomez, 3 Wall., 752.
Ex parte Zellner, 9 Wall., 244.
Vigo's case, 21 Wall., 648.
Ex parte Jordan, 94 U. S., 248.
Ex parte Cutting, 94 U. S., 14.
Ex parte South, etc., R. R. Co., 95 U. S., 221.
Com. of Patents *vs.* Whitely, 4 Wall., 522.

The case of Commissioner of Patents *vs.* Whitely, 4 Wall., 522, last above quoted, is especially interesting in this connection.

The 13 section of the Act of 1836 declared that, under the circumstances therein stated, "it shall be lawful for the Commissioner, upon the surrender to him of such patent," * * * "to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired, for which the original patent was granted in accordance with the patentee's corrected description and specification, and, in case of his death or any assignment by him made of the original patent, a similar right shall vest in his executors, administrators or assigns."

The seventh section of the Act provided, as we have had occasion hereinbefore to observe, that upon the filing of any application for a patent and the payment of the duty required by law, "the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery, etc."

The acts of 1839, 1852 and 1863 provided for an appeal to the Supreme Court of the District of Columbia from the decision of the Commissioner refusing a patent.

The applicant, Whitely, as the grantee of an exclusive sectional interest in a patent to one Jonathan Haines, filed an application for reissue of said patent. The Commissioner of Patents *declined to entertain the application* upon the ground that the applicant was only the grantee of an exclusive sectional interest and not the owner of the entire patent sought to be reissued. *He also declined to allow an appeal from his decision.*

An application was made to the Supreme Court of the District of Columbia for a writ of mandamus. That Court awarded a peremptory writ commanding the Commissioner "to refer said application to the proper examiner, or otherwise examine or cause the same to be examined according to law," and a writ of error was prosecuted to reverse that order.

In disposing of the case this Court, speaking through Mr. Justice Swayne, said:

"The Commissioner says, in his answer to the rule, that he could not examine the application because none had been filed in the Patent Office.

"This position is untenable. It is averred in the petition and not denied in the answer—and, therefore, as in other like cases of pleading, to be taken as conceded—that the application was filed with the Acting Commissioner. It is also admitted in the answer that the requisite amount of fees had been paid by the relator, but, it is added, that it had not been placed to the credit of the office and was in the hands of the chief clerk, subject to the relator's order.

"The relator had done all in his power to make his application effectual and had a right to consider it properly before the Commissioner.

"It was so. If it was not *a mandamus would clearly lie to compel the Commissioner to receive it.* It was his first duty to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and, indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with their proper fruit, were to follow, and they did follow.

"The Commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties? It required an answer before he could proceed further. His decision was against the appellant. His examination of the subject was thorough and his conclusion is supported by an able and elaborate argument. It was made a part of his reply to the rule, and is found in the record.

"From this decision, *whether right or wrong*, the relator had a right, under the Statute, to appeal.

"*If the mandamus had ordered the Commissioner to allow the appeal we should have held the order under which it was issued to be correct.* But the order was that he should proceed to examine the application. That he had already done. The preliminary question which he decided was as much within the scope of his authority as any other which could arise. Having resolved it in the negative there was no necessity for him to look further into the case. Enter-

> taining such views it would have been idle to do so. *The question* was vital to the application and its resolution was fatal so far as he was concerned. Only a reversal by the tribunal of appeal could revive it and cast upon him the duty of further examination."

This case is instructive in that it shows that the *refusal* of the Commissioner *to examine the merits of an invention set forth in* an application for a patent may amount to *a rejection of such application* and *a refusal of a patent thereon*, such as entitles an applicant to an appeal; and, furthermore, that where the right of appeal from the decision of the examining officer is obstructed the proper remedy is mandamus.

Within the reasoning of this case, the requirement of cancellation of relator's claims 7 to 13, inclusive, and the refusal to proceed further with the case was a refusal and rejection of the application *with those claims in it*, and the Commissioner's denial of a right of appeal from such refusal and rejection was error.

The present rule regulating appeals (133) would have barred Whitely's appeal, as the Commissioner in his case had not examined the merits of the invention claimed, had not decided, but had refused to decide, any question of novelty, utility, patentability or any other question affecting the merits of the *invention*, or any question as to the inoperativeness or invalidity of the original patent sought to be reissued. The only question the Commissioner did decide was that the assignee was not entitled to file and prosecute an application for a reissue and this court said, "From this decision, whether right or wrong, the relator had a right UNDER THE STATUTE, to appeal."

CONCLUSIONS.

1. An applicant for a method or process patent has, on principle, the inherent right to demand protection, in that patent, of all patentable invention he is compelled to disclose in setting forth his new method or process.

2. There is nothing in the statutes curtailing this right; on the contrary, the statute plainly indicates that he may have a single patent covering his whole invention.

3. The Commissioner's power to make regulations for the conduct of proceedings in his office gives him no authority to curtail this right.

4. The statutes do not prohibit the inclusion of claims for a process and claims for a machine for carrying such process into effect, in a single patent.

5. No original patent covering process and machine has ever been declared invalid on that account; on the contrary, such patents have been sustained, under objection. In relator's case the method or process claimed is carried out by the apparatus claimed and the apparatus claimed in its use necessarily practices the method or process claimed. This is not denied.

7. Whether the process and apparatus covered by relator's claims are interdependent is a question of fact, affecting the merits, requiring the judicial determination of the Examiner, and is appealable both under the statute and under the rules.

8. Assuming Rule 41 to be valid, the rejection of relator's application under it is not different, in kind, from a rejection and refusal under the statute itself and is appealable under the statute.

9. If the Commissioner has any discretion he has exhausted it by embodying it in a rule, and that rule, when

properly construed, does not prohibit the joining of process and apparatus claims in the same application if they cover inventions "that are dependent upon each other and mutually contribute to produce a single result."

10. The action of the Primary Examiner of the 31st day of July, 1900, requiring and demanding, a second time, the cancellation of claims 7 to 13, inclusive, of relator's application, was an adverse decision upon and a second rejection of, his said claims and of his said application.

11. Such decision and second rejection gives relator a right of appeal to the Board of Examiners in Chief, under Sections 482 and 4909 of the statute.

12. Such adverse decision and second rejection goes to the merits and gives relator a right of appeal under Rules 41 and 133, when properly construed.

13. If Rule 133 does not accord relator a right of appeal from a requirement of division, it is invalid and void, because inconsistent with law.

14. The allowance of an appeal such as relator prays will not necessarily warrant the allowance of appeals from decisions of Examiners under rules of mere procedure not in conflict with the statute regulating appeals.

15. No case of estoppel is made out against the relator.

16. If the Examiner's rejection rests upon an alleged estoppel, an appeal clearly lies, under the rules, for a judgment founded on an estoppel necessarily affects the merits.

17. As the Commissioner is obstructing a clear right of appeal, mandamus is relator's proper remedy.

The judgment below should be reversed.

FREDERIC H. BETTS,
MELVILLE CHURCH,
For Plaintiff in Error.

APPENDIX.

[Decision in *Ex parte* Bellingrodt.]

[54 MSS. Dec., 474.]

(Petition on question of merits dismissed.)
Hearing March 27, 1894.

UNITED STATES PATENT OFFICE.

Ex Parte MAURICE B. BELLINGRODT.

Pistons for Rotary Blowers.

PETITION.

Application filed April 20, 1893, No. 471,060.
Mr. George J. Murray for applicant.

This is a petition taken from the requirement of the Examiner "wherein he refuses to consider the case upon its merits until the previous requirement for division has been complied with."

Under present rule 64, questions of form are always subordinated to those of merits. The question of division therefore being one of form should be postponed, if the applicant is disposed to question the propriety of this requirement until after a final determination of the merits has been reached. One exception, however, should be recognized in this practice. It occurs in cases in which the Examiner is of the opinion that the patent, if granted, would be held invalid by the courts as covering two or more independent inventions. In such cases the Examiner should reject for this reason without making any examination upon the merits. From this action, when repeated, the applicant may, if he is disposed to contest this requirement, take an appeal to the Examiners-in-Chief. If the Examiners-in-Chief reverse the decision of the Primary Examiner, the require-

ment will, of course, be waived; if they affirm the decision of the Primary Examiner, an appeal may be taken to the Commissioner. If the Commissioner's decision is favorable to applicant, the requirement will be waived; if it is unfavorable, no further action on the merits of the case will be made by the Office, other than such action as will be necessary to conform to the decision of the Circuit Court of Appeals for the District of Columbia, if an appeal thereto should be taken. As the question is now presented, it is one of merits, and, therefore, cannot properly be passed upon by me at present.

The petition is therefore dismissed without prejudice.

S. T. FISHER,
Assistant Commissioner.

JUNE 4, 1894.